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In the United States Patent and Trademark Office

APPEAL No: 2005-0378
Serial No: 09/232,566
Confirm No: 1686
Appn Filed: 01/15/99
Applicant: Rolf Jansen
Appn Title: Tractor/Trailer Back-up Kit
Examiner/GAU: Tung Vo/2613
Technology Center: 2600

Mailed: 7-12-06

At: Houston, Texas

SUBMITTAL OF AMENDED 2ND SUPPLEMENTAL APPEAL BRIEF

Sir:

The appellant, Rolf Jansen, pro se, herewith files Amended 2nd Supplemental Appeal Brief, in triplicate, in response to the Notification of Non-Compliant Appeal Brief (37 CFR 41.37), mailed 06/16/06. Appellant submits check for \$250.00, the small entity fee for filing a brief.

Very respectfully,

Rolf Jansen
Rolf Jansen, appellant, pro se

P.O. Box 73161

Houston, TX 77273-3161

Certificate of Mailing

I certify that this correspondence will be deposited with the United States Postal Service as first class mail with proper postage affixed in an envelope addressed to: "Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" on the date below.

Date: 7-12-06

Rolf Jansen
Rolf Jansen, appellant, pro se



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AMENDED 2ND SUPPLEMENTAL APPEAL BRIEF

Applicant/appellant, Rolf Jansen, pro se, wishes to inform the Board of Patent Appeals and Interferences of the following:

BACKGROUND

Petition to Make Special, for reason IV-Applicant is over 65 years of age, was granted 9/27/04, by the Director Office, Technology Center 2600. Applicant/appellant is now age 72. Copy of the Decision on Petition is attached in the Related Proceedings appendix.

The Board of Patent Appeals and Interferences issued a Decision on Appeal, mailed 02/08/05, that stated: "The decision of the examiner to reject claims 3 and 4 is reversed," Copy of the Board's Decision is attached in the Related Proceedings appendix.

However, on 06/22/05, the examiner mailed a new Office Action that again rejected claims 3 and 4. Copy of the Office Action is attached as Exhibit 1.

On the date the Office was mailed, 37 CFR Sect 1.193(b)(2) (ii) was the relevant regulation controlling the appellant's response. Copy is attached as Exhibit 2.

In accordance with said regulation, the appellant prepared and filed a Request for Reinstatement of the Appeal. Copy is attached as Exhibit 3.

The appellant also filed, on 09/03/05, Appellant's 2nd Supplemental Brief. It was received by the PTO on 09/08/05. In the preparation of the brief, the appellant relied on 37 CFR Sect 1.192(c), which states:

"The brief shall contain the following items under appropriate headings and in the order indicated below unless the brief is filed by an applicant who is not represented by a registered practitioner." (Emphasis added.) Copy is attached as Exhibit 4.

The applicant, Rolf Jansen, pro se, has never been represented by a registered practitioner.

Then on 06/16/06, nine months after the brief had been received by the PTO, a Notification of Non-Compliant Appeal Brief (37 CFR 41.37) was mailed to the applicant/appellant. Copy is attached as Exhibit 5.

It says:

"1. The brief does not contain the items required under 37 CFR 41.37(c), or the items are not under the proper heading or in the proper order.

9. The brief does not contain copies of the decisions rendered by a Court or the Board in the proceeding identified in the Related Appeals and Interferences section of the brief as an appendix thereto (37 CFR 41.37(c)(1)(x))."

37 CFR 41.37(c), first appearing in the 07-01-05 Edition, changes the drafting rules for an applicant/appellant who is not represented by a registered practitioner. Copy is attached as Exhibit 6. Appellant had not been aware of this change.

The regulation reads as follows in 37 CFR 41.37(c)(1):

"The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(ii) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(i) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section." (Emphasis added.)

The appropriate headings and in the order indicated are as follows, in accordance with 37 CFR 41.37(c):

(I) Real party in interest; (II) Related appeals and interferences; (III) Status of claims; (IV) Status of amendments; (V) Summary of claimed subject matter; (VI) Grounds of rejection to be reviewed; (VII) Argument; (VIII) Claims appendix; (IX) Evidence appendix; (x) Related proceedings appendix.

The appellant will now proceed to follow 37 CFR 41.37(c), as it applies to an appellant, pro se; and will, by doing so, respond fully to the Notification of Non-Compliant Appeal Brief (37 CFR 41.37), mailed 06/16/06.

The regulation states that said appellant need only substantially comply with specified paragraphs, and is not required to give an answer to paragraph (V), Summary of claimed subject matter; and (VI), Grounds of rejection to be reviewed.

I

REAL PARTY IN INTEREST

The real party in interest is the named applicant/appellant, Rolf Jansen.

II

RELATED APPEALS AND INTERFERENCES

An appeal, identified by Appeal No. 2005-0378, concerning appellant, Rolf Jansen, pro se, and same application number, 09/232,566, was decided by the Board of Patent Appeals and Interferences, with Decision on Appeal, mailed 02/08/05, that stated:

"The decision of the examiner to reject claims 3 and 4 is reversed."

On 09/03/05 the applicant/appellant filed a Request for Reinstatement of the Appeal, in accordance with 37 CFR Sect 1.193 (b)(2)(ii), in response to an Office Action, mailed 06/22/05, reopening the prosecution and again rejecting claims 3 and 4.

Quoting from Manual of Patent Examining Procedure (MPEP) Section 1214.04, Examiner Reversed: (copy attached, Exhibit 7)

"The examiner should never regard such a reversal as a challenge to make a new search to uncover other and better references."

But this is exactly what the examiner did!

In one other proceeding, a Decision on Petition, by the Director Office, Technology Center 2699, Communications, was mailed 09/27/04, (Paper No. 18), in re Application of Rolf Jansen, Application No. 09/232,566.

The Decision Petition was in regard to two petitions by the applicant/appellant. One was a Petition to Make Special, for reason IV-Applicant is over 65 years of age. Said Decision granted the Petition to Make Special.

The other was a Petition to the Director pursuant to

37 CFR Sect 1.181, filed 10/12/01, to complain of unfair conduct of the examiner, with respect to the format of the appellant's brief.

The Decision on Petition stated on page 3, paragraph 4, that the appellant's brief substantially meets the requirement of 37 CFR Sect 1.192(c)(1,2, and 8) as defined by MPEP 1206 concerning Pro Se appellants.

In the following paragraph, said Decision on Petition states:

"Consequently, the Notice of Non-Compliance mailed September 20, 2001, requiring the pro see appellant to comply with all the requirements of 37 CFR Sect 1.192(c), was improper."

Copy of the Decision on Appeal and the Decision on Petition are attached in the Related Proceedings appendix. There are no Interferences related to the present appeal.

III

STATUS OF CLAIMS

Claims 3 and 4 were rejected in the Office Action, mailed 06/22/05, and it is these two claims that are being appealed.

IV

STATUS OF AMENDMENTS

The applicant/appellant Rolf Jansen, pro se, states that no amendment to any claim has been made subsequent to final rejection of all claims. Said final rejection came in the Office Action, dated 01/29/01. Copy is attached as Exhibit 8.

V

SUMMARY OF CLAIMED SUBJECT MATTER

37 CFR 41.37(c)(1) does not require an appellant who is not represented by a registered practitioner to answer this.

VI

GROUND'S OF REJECTION TO BE REVIEWED

37 CFR 41.37(c)(1) does not require an appellant who is not represented by a registered practitioner to answer this. The appellant has never been represented by a registered practitioner.

VII

ARGUMENT

The argument is in three main parts: VII(a) argues that the Board's reversal prohibited the examiner from reopening prosecution; VII(b), Response to the new rejection of claim 4; VII(c), Response to the new rejection of claim 3.

VII(a)

Attached as Exhibit 9 are copies of 37 CFR Sect 1.198, Section 1,196, and Section 1.114.

Section 1.198, titled Reopening after decision, states as follows:

"Cases which have been decided by the Board of Patent Appeals and Interferences will not be reopened or reconsidered by the primary examiner except under the provisions of Section 1.114 or Section 1.196 without the written authority of the Director, and then only for the consideration of matters not already adjudicated, sufficient cause being shown."

The exception in Section 1.114, titled Request for continued examination, states:

"(a) If prosecution in an application is closed, an applicant may request continued examination of the application by filing a submission and the fee set forth in Section 1.17(e)..."

The applicant/appellant has never requested a continued examination of the application, nor has he filed a submission, nor has he paid the set fee.

Section 1.114(d) further states: "An appeal brief under Section 1.192 or a reply brief under Section 1.193(b), or related papers, will not be considered a submission under this section."

Therefore, the exception of Section 1.114 does not apply in this case.

The exception in Section 1.196, titled Decision by the Board of Patent Appeals and Interferences, comes into being only if the Board makes a new ground of rejection. In this case the Board did not make a new ground of rejection.

In the Office Action, mailed 06/22/05, there is no mention of the examiner having received the written authority of the Director to reopen after decision of the Board of Patent Appeals and Interferences.

Yet, in spite of the clear language of 37 CFR Sect 1.198, the examiner rejected claims 3 and 4 again, after the Board of Patent Appeals and Interferences had decided the case.

Quoting from Manual of Patent Examining Procedure (MPEP) Section 1214.04, Examiner Reversed: (copy attached, Exhibit 7)

"The examiner should never regard such a reversal as a challenge to make a new search to uncover other and better references."

But this is exactly what the examiner did, in clear violation MPEP Section 1214.04.

Therefore, the appellant very respectfully requests that the Board of Patent Appeals and Interferences overrule and rescind the office Action, mailed 06/22/05.

VII(b)

RESPONSE TO THE NEW REJECTION OF CLAIM 4

What the Office Action states in regard to claim 4:

"2. The following is a quotation of the second paragraph of U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Regarding claim 4, line 3, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP Section 2173.05(d).

Claim 4, Line 8, "the ideal position" is indefinite. It is not clear that which position of the camera is mounted. Appropriation correction is required.

7. Claim 4 would be allowable if rewritten or amended

to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action."

Here is the wording of claim 4:

"4. An assembly of a micro-video, pin-holed lens camera, comprising means for mounting said assembly on the reverse side of a plate, such as a license plate, at the rear of a trailer or motor vehicle, so that said camera can see through a predetermined-sized hole put in said plate, whereby said plate-mounted assembly conceals said pin-holed lens camera to lessen the risk of vandalism, whereby said camera is located in the ideal position at the rear of a trailer or motor vehicle for viewing a backing when used in conjunction with a monitor."

Appellant's response pertaining to rejection of claim 4:

A. The examiner issued three previous Office Actions, dating back to the year 2000, and never objected to the words to which he now objects. An inference can be drawn that the words are not objectionable; otherwise, the examiner would have objected to them before now.

Instead, he brings the objection for the first time over 4 months after the Board of Patent Appeals and Interferences had decided the case.

B. A license plate is one particular type of plate. If the appellant were to write his claim to pertain to only a license plate, some one could easily evade a patent by hiding the tiny camera behind a plate that says, THINK SAFETY, or THIS VEHICLE MAKES WIDE RIGHT TURNS.

C. Quoting from Manual of Patent Examining Procedure, Section 2173.02, on page 2100-199 (copy attached as Exhibit 10)

"The mere use of the phrase "such as" in the claim does not by itself render the claim indefinite. Office policy is not to employ per se rules to make technical rejections. Examples of claim language which have been held to be indefinite set forth in MPEP Section 2173.05(d) are fact specific and should not be applied as per se rules. The test for definiteness under 35 U.S.C. 112, second paragraph is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification."

The appellant asserts that a person skilled in the art would understand claim 4.

D. Here is an explanation as to why the appellant used the term "ideal position" in claim 4:

Why put the camera behind a plate, such as the trailer license plate?

First, the little camera stays out of sight.

The plate can easily be centered and mounted just under the rear edge of the trailer floor.

If you mount the camera by either back-up light, the driver won't have a balanced center view.

If you mount the camera on the trailer roof, the field of view of the lens won't see any of the area close to the rear of the trailer, which is crucial to see when backing to a loading dock.

If you mount the camera along the back edge of the trailer floor, a slight bump against the loading dock will damage the camera.

"Ideal position" is an appropriate term because the position described is ideal by objective criteria.

Further, the appellant asserts that a person skilled in the art would understand this part of claim 4.

E. After the U.S. Supreme Court ruled in Festo v Shoketsu, 122 S.Ct. 1831 (2002), there are dire consequences if an applicant changes the wording of a claim to satisfy an examiner.

A copy of this case is attached as Exhibit 11. Quoting from page 3 of 12, Key Cite this headnote (10):

"Patentee alleging infringement under doctrine of equivalents has burden of proving that narrowing amendment made during patent prosecution did not surrender particular equivalent in question."

Quoting from page 8 of 12, at the bottom of major caption A:

"On the other hand, if a section 112 amendment is necessary and narrows the patent's scope -- even if only for the purpose of better description -- estoppel may apply. A patentee who narrows a claim as a condition for obtaining a patent disavows his claim to the broader subject matter, whether the amendment was made to avoid the prior art or to comply with section 112." (Emphasis added.)

F. So, the appellant states right now that he declines to accept the examiner's offer to allow claim 4 if the applicant/appellant makes changes to claim 4 at this late stage.

G. The appellant very respectfully requests that the Board of Patent Appeals and Interferences reverse the examiner's rejection of claim 4.

VII(c) -- RESPONSE TO THE NEW REJECTION OF CLAIM 3

What the Office Action states in regard to claim 3:

"1. In view of the newly discovered references, DE 33 16 818, US 6,259,475, and US 6,172,600, PROSECUTION IS HEREBY REOPENED."

Response:

This clearly shows the examiner has reopened prosecution in spite of 37 CFR Section 1.198, after the Board of Patent Appeals and Interferences had decided the case.

The examiner has not given a single word of explanation in the body of the Office Action as to why these two patents (US 6,259,475 and US 6,172,600) in combination with DE3316818 warrant rejecting claim 3.

The appellant has read US 6,259,475 (Ramachandran), 40 pages, and US 6,172,600 (Kakinami, et al), 19 pages; and he asserts that neither of them shows the applicant/appellant's invention or renders it obvious, when combined with DE3316818, to which the appellant will respond in text further down in this brief. (No copy of any US patent came with the O.A.)

What the examiner states in the Office Action additionally in regard to claim 3:

"5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hans-Hellmut Ernst (DE 33 16 818) in view of Lee (US 5,680,123).

Re claim 3, Ernst teaches an assembly of a camcorder-type crystal display monitor (elements 1-8 of the figure) comprising means (element 7 of figure) for mounting said assembly (elements 1-6 and 8 of the figure) to the inner retracted side of a driver's sun-visor (see the translation of DE 33 16 818, page 4 lines 1-10) a motor vehicle, whereby said sun-visor, when lowered, allows a driver easy, direct, close-range, sun-light-protected viewing of said monitor screen (see the translation of DE 33 16 818, page 4, line 19, page 5, line 2), as if the screen were a rear-view mirror (element 2 of the figure), when used in conjunction with a video phone (element 11 of the figure). Ernst further suggests means of connecting socket (element 6 of the figure) earphones (element 9 of the figure), game-pilot lever 11 or external devices can be connected to provide video telephone signal to the display (element 2 of the figure).

It is noted that Ernst does not particularly teach the screen display, when used in conjunction with a video camera to see to the rear when the unaided view is obstructed as claimed.

However, Lee teaches video cameras (62, 64, and 66 of fig. 5), a third video camera (66 of fig. 6) mounted on a rear the vehicle to view an object present in the rear region of the

vehicle (C fig. 1a), wherein the rear image is transmitted to a display monitor placed in the front of the vehicle for a driver viewing (74 of fig. 5), so this suggests the screen display, when used in conjunction with a video camera to see to the rear when unaided view is obstructed.

Therefore, taking the teachings of Ernst and Lee as a whole, it would have been obvious to one of ordinary skill in the art to modify the video cameras (62, 64, and 66 of fig. 6) of Lee into the assembly of the camcorder-type crystal display monitor of Ernst to detect and display objects not readily visible to the vehicle operator.

Doing so would allow the driver to view the hidden object captured by the camera without turning his or her head in the blind spot."

Here is claim 3:

3. An assembly of a camcorder-type liquid crystal display monitor, comprising means for mounting said assembly to the inner retracted side of a driver's sunvisor of a motor vehicle,

whereby said sunvisor, when lowered, allows a driver easy, direct, close-range, sunlight-protected viewing of said monitor screen, as if the screen were a rear-view mirror, when used in conjunction with a video camera, to see to the rear when the unaided view is obstructed.

Appellant's Response

Please notice that only the first page of the translation is attached to the German patent, DE 33 16 818, copy of which

is attached as Exhibit 12. This is the way the reference came in the mail from the PTO.

Attached as Exhibit 13 is copy of appellant's Request for Copy of Missing Reference, with card showing it was received by the PTO on July 5, 2005. Two months have since passed, and still the appellant has not received a copy of the translation.

The appellant does not read German. Translations of foreign patents are not available through the Patent and Trademark Depository Library, at Fondren Library, Rice University, Houston, Texas.

When the examiner in rejecting claim 3 refers to specific parts of the translation of a German patent (DE 33 16 818), giving page numbers, certainly the appellant is entitled to a complete copy of the translation in order to prepare a response, and to have the copy for his records.

Since the appellant has not received the translation of the German patent except for the 1st page of at least 5 pages in spite of writing to request the translation and waiting for 2 months to receive it, the appellant respectfully urges the Board not to consider any arguments the examiner might present in an Answer that relate to this translation.

Also, the appellant never received a copy of the examiner's Answer to Appellant's Supplemental Brief. Appellant learned on October 29, 2004, from correspondence from a lawyer in the Commissioner's Office, pertaining to a partial refund of a fee payment, that the examiner had filed an Answer on August 16, 2002.

Appellant sent a Notice of Non-Receipt of Examiner's Answer, with corroborating documentation, to the PTO on November 1, 2004, and return card showed the PTO received

said Notice on November 5, 2004. The appellant had requested that he be sent a copy of the examiner's Answer.

All of this transpired when the case on appeal was on the docket, and appellant had received notification from the Board that Examiner's Answer had been received and that appellant had filed no Reply brief. Very distressing! He couldn't file a Reply brief because he had never received a copy of the Examiner's Answer.

To this date the appellant has never received a copy of the Examiner's Answer to Appellant's Supplemental Brief.

A pattern has developed wherein the appellant is not receiving copies of very important documents from the PTO that bear on the appellant's ability to defend claims.

Continuing Appellant's Response

A. Please notice that in the drawing of the sun visor in Ernst (DE 33 16 818), the attachment post (where the sun visor attaches to the interior body of the car) is on the right.

In the United States cars drive on the right side of the road, and the passenger's sun visor mounts on the right.

Ernst (DE 33 16 818) is a German patent. On which side of the road do cars travel in Germany?

Quoting from Car Driving Information for Germany (obtained over the Internet), that is attached as Exhibit 14.

"Rules of the Road. Traffic travels on the right..."

So, the sun visor in Ernst is the passenger's sun visor; and the examiner is mistaken in stating that it is the driver's sun visor.

B. The examiner states that Ernst (DE 33 16 818) has a camcorder-type liquid crystal display. The appellant plans to prove that he is in error:

The term camcorder-type liquid crystal display (LCD) indicates that it shows video (motion pictures) and is small and thin.

Video is absolutely essential to claim 3; otherwise, the display monitor could not show the actual view of the area to which the driver is backing.

On a camcorder the LCD serves as the electronic viewfinder (EVF).

Quoting from Newnes Television and Video Engineer's Pocket Book, Third Edition, by Eugene Trundle, TMIIE (elect.), MRTS, MISTC, published in 1999, copy of 4 pages of which is attached as Exhibit 15.

From page 149:

"Colour EVF. The fact that colour viewfinders struggle to do justice to the performance of a good video camera has not prevented manufacturers incorporating them in home-movie camcorders! A few models offer the best of both worlds, with a conventional black-and-white VF tube plus a small (4-10 cm diagonal) colour LCD display in a fold-out panel on one side of the camcorder body."

From page 148:

"The norm then, is a black-and-white viewfinder tube of about 2.5 cm diagonal mounted in a 'chicken-leg' housing hinged at its back end on the top surface of the camera. It has an eyepiece and viewing lens with focus adjustment."

Further down page 148:

"Although physically very small, the components and

techniques of the EVF are just the same as are used in the TV receiver and monitors covered in the first half of this book."

Now quoting from Troubleshooting and Repairing Camcorders, by Homer L. Davidson, published in 1990 by McGraw-Hill, Inc., copy of 5 pages of which is attached as Exhibit 16.

From page 92:

"THE ELECTRONIC VIEWFINDER

Although the most recent camcorders have the electronic viewfinder, some of the smaller cameras have the optical viewfinder. The electronic viewfinder (EVF) permits monitoring the image being shot or played back. The electronic viewfinder looks and acts somewhat like the small black-and-white TV chassis. The EVF unit is found at the front of the camcorder (FIG. 3-35).

"The EVF circuits consist of a miniature picture tube with horizontal and vertical deflection circuits. The flyback transformer provides high voltage to the CRT. Vertical and horizontal sync circuits are generated and fed to the EVF deflection and VCR system control circuits. A small amplifier and sync separation circuit round up the EVF circuits (FIG. 3-36)."

FIG. 3-35 and 3-36 are included in Exhibit 16.

Why was no mention made of LCD viewfinders in this 1990 edition?

Appellant wishes to make a very short quote from another source, and then will answer the question.

Quoting from Practical Electronics for Inventors, by Paul Scherz, published by McGraw-Hill in 2000, copy of 3 pages of which is also attached as part of Exhibit 16.

From page 521:

"One disadvantage with LCDs is their slow switching speeds (time it takes for a new digit/character to appear)."

For an LCD to show video (motion pictures) it must have a high switching speed (refresh rate), or else the picture will be badly blurred.

To make an LCD viewfinder (camcorder-type liquid crystal display) technology must advance to greatly increase switching speed and incorporate all of the components of a TV receiver into a small package.

Why no mention of LCD viewfinders in Troubleshooting and Repairing Camcorders, published in 1990? In 1990 they were not yet available.

Now please take a look at the first page of Ernst (DE 33 16 818). The filing date is May 7, 1983, long before 1990. LCD viewfinders (camcorder-type liquid crystal displays) that show video certainly were not available in 1983.

Therefore, Ernst (DE 33 16 818) does not have a camcorder-type liquid crystal display, and the examiner is in error to state that it does.

Further, appellant will show that Ernst (DE 33 16 818) can't show the other kind of video based on the CRT (cathode ray tube). He will show that Ernst can't show any video:

The only TVs or video monitors available in 1983 were of the CRT type. All of them are bulky, impossible to mount within the confines of the thickness of a passenger's sun visor.

To corroborate this, attached as Exhibit 17 is copy of 2 pages from Consumer Reports, June 2005, and quoting from p. 46:

"BULKY. Most CRTs' depth equals their screen size."

So, Ernst (DE 33 16 818) pertains to no TV, no video of any kind.

C. A copy of Lee (US 5,680,123) is attached as Exhibit 18. Lee states in its Abstract the following:

"The vehicle monitoring system uses a plurality of video cameras mounted on various location of a vehicle to detect and display of objects not readily visible to the vehicle operator. In particular, video cameras are placed on each side of the vehicle and, preferably, on the rear portion of the vehicle. Each camera is connected to a display unit and/or video recorder through a video multiplexer which is controlled by a main controller. The views from different cameras are displayed or recorded in response to the position of a turn signal control switch. Alternatively, the cameras can be activated when a vehicle alarm is triggered or when the vehicle is hit from the behind."

In Lee, a display unit is mounted in the center of the dashboard. The patent does not tell specifically where a camera in the rear is placed.

D. The person of ordinary skill in the art is not obviously going to think of claim 3 because of his knowledge of Ernst and Lee, because claim 3 depends on video, and Ernst has no video of any kind, and Ernst pertains to a passenger's sun visor, and claim 3 pertains to a driver's sun visor.

E. There is nothing in the prior art of Ernst (DE 33 16 818) and Lee (US 5,680,123) about a display assembly that clips onto the driver's sun visor. The clip-on display assembly is a novel and useful feature of claim 3. This feature is described in the specifications, pages 10, 19, 36; and a copy of said pages is attached as Exhibit 19. Relevant sentences are marked on the pages.

Certain properties are inherent in use of a clip -- namely, easy attachment and easy detachment of the assembly from the driver's sun visor.

For example: These properties allow the assembly to be quickly moved from one truck tractor to another, or, to be easily taken to a safer place, away from risk of theft, if the truck tractor is to be parked unattended for an extended time.

In comparison, the display assembly in Ernst is built into the passenger's sun visor. And the display assembly in Lee is built into the center of the dashboard.

Further, the clip-on display assembly of claim 3 is simpler, and therefore, less costly to make and install, than the more complex display assemblies of Ernst and Lee.

In re Wright, 6 USPQ2d 1959, 1962 (Fed. Cir. 1988), a copy of which is attached as Exhibit 20, the Court of Appeals held that:

"Factors including unexpected results, new features, solution of a different problem, novel properties, are all considerations in the determination of obviousness in terms of U.S.C. section 103." (Emphasis added.)

The above quote is found on page 1962, beginning at line 16.

Summary Paragraphs

Appellant has reviewed each of the references, listed on the Notices of References Cited, that was not relied upon, Appellant asserts that none of them shows the appellant's invention or renders it obvious.

The appellant submits that this application is now in full condition for allowance, which action he very respectfully solicits.

WHEREFORE, on the basis of the evidence and argument presented herewith, the appellant very respectfully requests that the Board of Patent Appeals and Interferences:

1. Overrule and rescind the Office Action, mailed 06/22/05, and order the examiner to immediately allow claims 3 and 4, as written.

2. Or in the alternative, reverse the examiner's decision rejecting claims 3 and 4, and order the examiner to immediately allow claims 3 and 4, as written.

The appellant also requests general relief.

Very respectfully,

Rolf Jansen

Rolf Jansen

Appellant, pro se

P.O. Box 73161

Houston, TX 77273-3161

281-440-6907

Verification

Appellant, Rolf Jansen, pro se, hereby declares that all statements made herein of his own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this verified statement is directed.

Rolf Jansen

Rolf Jansen

Appellant, pro se

Date of signature: 7-12-06

Certificate of Mailing

I certify that this correspondence will be deposited with the United States Postal Service as first class mail with proper postage affixed in an envelope addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" on the date below.

Date: 7-12-06

Rolf Jansen

Rolf Jansen

Appellant, pro se

CLAIMS APPENDIX

Appellant's claims are:

3. An assembly of a camcorder-type liquid crystal display monitor, comprising means for mounting said assembly to the inner retracted side of a driver's sunvisor of a motor vehicle,

whereby said sunvisor, when lowered, allows a driver easy, direct, close-range, sunlight-protected viewing of said monitor screen, as if the screen were a rear-view mirror, when used in conjunction with a video camera, to see to the rear when the unaided view is obstructed.
4. An assembly of a micro-video, pin-holed lens camera, comprising means for mounting said assembly on the reverse side of a plate, such as a license plate, at the rear of a trailer or motor vehicle, so that said camera can see through a predetermined-sized hole put in said plate,

whereby said plate-mounted assembly conceals said pin-holed lens camera to lessen the risk of vandalism,

whereby said camera is located in the ideal position at the rear of a trailer or motor vehicle for viewing a backing, when used in conjunction with a monitor.

EVIDENCE APPENDIX

37 CFR 41.37(c)(1)(ix) states the following about what is to be included in the Evidence appendix:

"An appendix containing copies of any evidence submitted pursuant to Section 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See Sect 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal."

Appellant states that there is no evidence in this case about Sections 1.130, 1.131, or 1.132, which have to do with affidavits. Also, there is no evidence entered by the examiner that the appellant relies upon in the appeal. Also, there is no evidence in this case of the kind described in Sect 41.33, regarding amendments and affidavits. There is nothing in said paragraph about including copies of the evidence relied upon by the appellant. The key word in the last sentence in the paragraph above from 37 CFR 41.37(c)(1)(ix) is "may". "This appendix may also include..." The word "may" means the inclusion is optional, and the appellant, for reasons of coherence and unity, prefers to put all of his documentary evidence, marked by sequential exhibit numbers, in a separate Exhibits appendix, to come after the Related proceedings appendix.

RELATED PROCEEDINGS APPENDIX

Copies included herewith:

Decision on Appeal by Board of Patent Appeals and
Interferences, mailed 02/08/05

Decision on Petition by Director Office, Technology
Center 2600, mailed 09/27/04

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROLF JANSEN

Appeal No. 2005-0378
Application No. 09/232,566

ON BRIEF

Before MCQUADE, NASE and BAHR, Administrative Patent Judges.
MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Rolf Jansen originally took this appeal from the final rejection (Paper No. 6) of claims 3 and 4, the only claims pending in the application. Upon consideration of the appellant's main brief (Paper No. 9), the examiner issued an Office action (Paper No. 12) reopening prosecution and entering superseding rejections of the claims. Pursuant to 37 CFR § 1.193(b)(2)(ii), the appellant then filed a supplemental brief (Paper No. 16) and requested that the appeal be reinstated.

Implicitly granting the request, the examiner entered an answer (Paper No. 17) and forwarded the application to this Board for review of the new rejections of claims 3 and 4.

THE INVENTION

The invention relates to a system that enables the driver of a tractor/trailer rig to see the area behind the trailer from the cab of the tractor when backing the rig. Claims 3 and 4 read as follows:

3. An assembly of a camcorder-type liquid crystal display monitor, comprising means for mounting said assembly to the inner retracted side of a driver's sunvisor of a motor vehicle,

whereby said sunvisor, when lowered, allows a driver easy, direct, close-range, sunlight-protected viewing of said monitor screen, as if the screen were a rear-view mirror, when used in conjunction with a video camera, to see to the rear when the unaided view is obstructed.

4. An assembly of a micro-video, pin-holed lens camera, comprising means for mounting said assembly on the reverse side of a plate, such as a license plate, at the rear of a trailer or motor vehicle, so that said camera can see through a predetermined-sized hole put in said plate,

whereby said plate-mounted assembly conceals said pin-holed lens camera to lessen the risk of vandalism,

whereby said camera is located in the ideal position at the rear of a trailer or motor vehicle for viewing a backing, when used in conjunction with a monitor.

THE PRIOR ART

The references relied on by the examiner as evidence of obviousness are:

Abersfelder et al. (Abersfelder)	5,646,614	Jul. 08, 1997
Aviv	5,666,157	Sep. 09, 1997
Asakawa et al. (Asakawa)	5,892,598	Apr. 06, 1999
Frankhouse et al. (Frankhouse)	5,940,120	Aug. 17, 1999

THE REJECTIONS

Claim 3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Frankhouse in view of Asakawa.

Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Abersfelder in view of Aviv.

Attention is directed to the briefs and answer for the respective positions of the appellant and examiner regarding the merits of these rejections.

DISCUSSION

I. The 35 U.S.C. § 103(a) rejection of claim 3 as being unpatentable over Frankhouse in view of Asakawa

Frankhouse discloses "a vanity console for use in a vehicle and one which provides an illuminated vanity mirror and/or video

imaging" (column 1, lines 4 through 6). With regard to the video imaging aspect of the console, Frankhouse teaches that

positioned centrally behind the mirror is a video image source, such as an LCD display, which is supplied with video information from a variety of sources such as vehicle mounted cameras such that the vanity console can serve the additional function of video imaging. . . . [T]he system may include cameras directed forwardly and/or rearwardly of the vehicle for providing rear visibility for parking, internal rear visibility for conversation with rear seat passengers or forward visibility utilizing an enhanced light amplification camera for providing video images under low ambient light conditions [column 1, line 59, through column 2, line 5].

As shown in Figure 9, the vehicle may include a rear vision camera 96 mounted at the back of the vehicle, preferably in the rear bumper area. This camera communicates with a display monitor 90 housed in the console to show objects behind the vehicle (see column 5, lines 36 through 58).

Of particular interest in this appeal is the location of the console/monitor. Frankhouse describes a number of convenient locations in which the console can be placed (see column 3, lines 26 through 35), but makes clear that the console should not be mounted on a sunvisor as this would limit desirable vanity characteristics of the console, interfere with the use of the sunvisor and block the driver's view of the roadway (see column 1, lines 7 through 38).

The examiner concedes that Frankhouse does not respond to the limitation in claim 3 requiring "means for mounting said assembly to the inner retracted side of a driver's sunvisor of a motor vehicle." To account for this difference, the examiner cites Asakawa.

Asakawa discloses a head up display unit (HUD) "which can be used in any place in the interior of an automobile" (Abstract). As a practical matter, the HUD, which has a thin transparent construction, is placed on or in the vicinity of the windshield to allow it to superimpose information on the forward scene viewed by the driver. In the embodiment shown in Figure 2, the HUD 1' "is attached like a sunvisor and is pulled down forward of the driver's seat as needed" (column 9, lines 15 and 16).

In proposing to combine Frankhouse and Asakawa to reject claim 3, the examiner submits that it would have been obvious at the time the invention was made to a person having ordinary skill in the art "to modify the teachings of Asakawa into the housing (24) of the vanity console of Frankhouse for the same purpose of mounting the LCD on the sunvi[s]or so that the driver easily views the captured video image during backing up the car without turning the driver's head" (answer, page 4).

Frankhouse, however, expressly teaches away from mounting the console on a sunvisor. Moreover, and contrary to a finding made by the examiner (see page 4 in the answer), Asakawa does not specifically teach mounting the HUD on a sunvisor. In the embodiment 1' relied on by the examiner in this regard, the HUD is merely attached "like a sunvisor," but is not ostensibly mounted on one. In this light, it is evident that the only suggestion to combine Frankhouse and Asakawa in the manner proposed by the examiner to reject claim 3 stems from hindsight knowledge impermissibly derived from the appellant's disclosure.

Accordingly, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claim 3 as being unpatentable over Frankhouse in view of Asakawa.

II. The 35 U.S.C. § 103(a) rejection of claim 4 as being unpatentable over Abersfelder in view of Aviv

Abersfelder discloses a system for effectively monitoring potential parking spaces from a motor vehicle:

[t]hese needs are met according the present invention by a system having a video camera built into either the front or rear of the vehicle and a viewing and monitoring device in the field of view of the vehicle driver connected to the camera. The field of view is fitted with a display screen. The video camera is equipped with means for its pivoting (turn and tilt) as a function of electric drive signals and is of the type having object referenced image sharpness control of its optics [column 1, lines 38 through 46].

Abersfelder's Figures 1 and 2 schematically illustrate the video camera 11 built into the rear 12 of a vehicle 10 and the viewing and monitoring device 15 located so as to be within the visual range of the vehicle driver.

The examiner acknowledges that Abersfelder does not respond to the limitation in claim 4 requiring "means for mounting said assembly on the reverse side of a plate, such as a license plate, at the rear of a trailer or motor vehicle, so that said camera can see through a predetermined-sized hole put in said plate." Nonetheless, the examiner finds and concludes that

it is well established that one skilled in the art would have [found it] obvious to mount the camera anywhere on the car, particularly on the reverse side of a license plate at the rear of the vehicle, and the camera can see through a predetermined-sized hole put in the license plate [for] a rear view when the vehicle is backing [answer, page 4].

The examiner, however, has failed to advance the requisite factual basis necessary to support such a finding/conclusion. This fundamental flaw in the examiner's evidentiary showing finds no cure in the citation of the Aviv patent for its disclosure of a hidden surveillance camera having a pin hole lens (see column 9, lines 54 through 65).

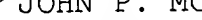
Hence, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claim 4 as being unpatentable over Abersfelder in view of Aviv.


Appeal No. 2005-0378
Application No. 09/232,566

SUMMARY

The decision of the examiner to reject claims 3 and 4 is reversed.

REVERSED


JOHN P. MCQUADE
Administrative Patent Judge


JEFFREY V. NASE
Administrative Patent Judge

BOARD OF PATENT
APPEALS
AND
INTERFERENCES


JENNIFER D. BAHR
Administrative Patent Judge

JPM/gjh

Appeal No. 2005-0378
Application No. 09/232,566

ROLF JANSEN
P.O. BOX 73161
HOUSTON, TX 77273



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
ALEXANDRIA, VA 22313-1450
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MAIL

Paper No. 18

SEP 27 2004

DIRECTOR OFFICE
TECHNOLOGY CENTER 2600

DECISION ON PETITION

ROLF JANSEN
P O BOX 73161
HOUSTON TX 77273

In re Application of :
Rolf Jansen :
Application No. 09/232,566 :
Filed: January 15, 1999 :
For: **TRACTOR/TRAILER BACK UP KIT** :

This is a decision on the Petition to Make Special filed August 30, 2001 under MPEP §708.02 (IV), applicant's age and also a decision on the Petition to the Director pursuant to 37 CFR § 1.181, filed October 12, 2001.

A petition to make special under MPEP §708.02, IV, must show that petitioner is 65 years of age, or more. Acceptable evidence includes a birth certificate, copy of a driver's license, or simply a statement by the applicant. No fee is required.

The petition includes a declaration executed by Rolf Jansen in support of the petition, evidencing that he is over 65 years of age.

Accordingly, the petition to make special is **GRANTED**.

The application will retain its special status throughout its entire prosecution, including any appeal to the Board of Patent Appeals and Interferences, subject only to diligent prosecution by the applicant.

Regarding applicant's petition to the Director, the petition is to "...complain of unfair conduct of the examiner, with respect to the format of the appellant's brief". Specifically, petitioner requests that the "Commissioner of Patents and Trademarks overrule and rescind the examiner's order of September 20, 2001 holding the Brief non-compliant.

A review of the application reveals that the U.S. Patent and Trademark Office (Office) mailed a final Office action on January 29, 2001. Applicant filed a request for two month extension of time on April 24, 2001 and then filed on June 28, 2001, via certificate of mailing, a Notice of Appeal. On August 30, 2001 applicant timely filed the brief in question as well as the petition to make special as addressed above. On September 20, 2001, the Office mailed out a Notice of Non-Compliance for failure to comply with numerous sections of 37 CFR §1.192(c). On October 12, 2001, applicant filed the subject petition and a request for a one month extension of time (paying for three months) to respond to the Notice of Non-Compliance. On December 12, 2001 (11/20/01 with certificate of mailing) applicant filed for another one month extension of time to respond to the Notice of Non-Compliance. This should have been a request for two month extension with first month previously paid. Instead, applicant paid for four months extension of time. On January 16, 2002 (12/19/01 with certificate of mailing) applicant filed a request for a third one month extension of time to respond to the outstanding Notice of Non-Compliance. This should have been a request for three month extension of time with the first two months having been previously paid for. Instead, applicant paid for five months extension of time. On January 31, 2002 the Office mailed a new non-final Office action, essentially reopening prosecution. Unfortunately, a statement to that effect is not noted in the new Office

communication. On February 22, 2002 (1/19/02 certificate of mailing) applicant filed a petition pursuant to 37 CFR §1.182 requesting grant of extension of time until the 37 CFR §1.181 petition is decided, stating that "...applicant has mailed all the payments to the PTO for extensions of time to respond to the examiner's action of 9/20/01, that are allowable". On June 3, 2002 (5/30/02 certificate of mailing), applicant filed a one month extension of time, a request for reinstatement of the appeal and a supplemental appeal brief. On August 16, 2002, the examiner prepared and mailed an answer to appellant's brief.

MPEP §1206 Appeal Brief, states in part:

APPEAL BRIEF CONTENT...

An exception to the requirement that all the items specified in 37 CFR 1.192(c) be included in the brief is made if the application or reexamination proceeding is being prosecuted by the appellant pro se, i.e., there is no attorney or agent of record, and the brief was neither prepared nor signed by a registered attorney or agent. The brief of a pro se appellant which does not contain all of the items, (1) to (9), specified in 37 CFR 1.192(c) will be accepted as long as it substantially complies with the requirements of items (1), (2), and (8). If the brief of a pro se appellant is accepted, it will be presumed that all the claims of a rejected group of claims stand or fall together unless an argument is included in the brief that presents reasons as to why the appellant considers one or more of the claims in the rejected group to be separately patentable from the other claims in the group. [emphasis added]

37 CFR §1.192 Appellant's brief, states in part:...

(c) The brief shall contain the following items under appropriate headings and in the order indicated below unless the brief is filed by an applicant who is not represented by a registered practitioner:

- (1) Real party in interest. A statement identifying the real party in interest, if the party named in the caption of the brief is not the real party in interest.
- (2) Related appeals and interferences. A statement identifying by number and filing date all other appeals or interferences known to appellant, the appellant's legal representative, or assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal...
- (8) Argument. The contentions of appellant with respect to each of the issues presented for review in paragraph (c)(6) of this section, and the basis therefor, with citations of the authorities, statutes, and parts of the record relied on. Each issue should be treated under a separate heading.
 - (i) For each rejection under 35 U.S.C. 112, first paragraph, the argument shall specify the errors in the rejection and how the first paragraph of 35 U.S.C. 112 is complied with, including, as appropriate, how the specification and drawings, if any,
 - (A) Describe the subject matter defined by each of the rejected claims,
 - (B) Enable any person skilled in the art to make and use the subject matter defined by each of the rejected claims, and
 - (C) Set forth the best mode contemplated by the inventor of carrying out his or her invention.
 - (ii) For each rejection under 35 U.S.C. 112, second paragraph, the argument shall specify the errors in the rejection and how the claims particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(iii) For each rejection under 35 U.S.C. 102, the argument shall specify the errors in the rejection and why the rejected claims are patentable under 35 U.S.C. 102, including any specific limitations in the rejected claims which are not described in the prior art relied upon in the rejection.

(iv) For each rejection under 35 U.S.C. 103, the argument shall specify the errors in the rejection and, if appropriate, the specific limitations in the rejected claims which are not described in the prior art relied on in the rejection, and shall explain how such limitations render the claimed subject matter unobvious over the prior art. If the rejection is based upon a combination of references, the argument shall explain why the references, taken as a whole, do not suggest the claimed subject matter, and shall include, as may be appropriate, an explanation of why features disclosed in one reference may not properly be combined with features disclosed in another reference. A general argument that all the limitations are not described in a single reference does not satisfy the requirements of this paragraph.

(v) For any rejection other than those re-ferred to in paragraphs (c)(8)(i) to (iv) of this section, the argument shall specify the errors in the rejection and the specific limitations in the rejected claims, if appropriate, or other reasons, which cause the rejection to be in error.

The appellant's brief of August 30, 2001 substantially meets the requirement of 37 CFR §1.192(c)(1,2 and 8) as defined by MPEP 1206 concerning Pro Se appellants. Specifically, the appellant states that they are a pro-se appellant, that appellant was not represented by a registered practitioner and that this was the first appeal brief they had ever written (taken as satisfying the requirement of 37 CFR §1.192 (c)(2)), and the brief contained presentation of arguments to each of the issues presented in the Office action.

Consequently, the Notice of Non-Compliance mailed September 20, 2001, requiring the pro-se appellant to comply with all of the requirements of 37 CFR §1.192(c), was improper.

Therefore, appellant's brief should have been considered by the Office. Given that prosecution was re-opened in view of a new grounds of rejection on January 31, 2002, the Office's Non-Compliant Notice is vacated.

Accordingly, petitioner's request that the "examiner's order of September 20, 2001" be rescinded, is **Dismissed as Moot**.

It is noted that the pro-se appellant's supplemental appeal brief has been considered as having met the requirements of 37 CFR §1.192 and has been treated in the Examiner's Answer mailed August 26, 2002.

The application will be forwarded to the Office of Patent Legal Administration (OPLA) to address applicant's 37 CFR 1.182 petition regarding fees paid and request for extensions of time. From there, the application will be forwarded to the Board of Patent Appeals and Interferences for decision of the appeal.

Reinold Enif For
Mark Powell, Director
Technology Center 2600
Communications

EXHIBITS APPENDIX

In the text of the brief, when a relevant document is first mentioned, it is given an exhibit number. Exhibits (copies) contain numbered side tabs, so the reader can easily find the document.



UNITED STATES PATENT AND TRADEMARK OFFICE

EXHIBIT 1

7 PAGES

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/232,566	01/15/1999	ROLF JANSEN		1686

7590 06/22/2005

ROLF JANSEN
P O BOX 73161
HOUSTON, TX 77273

EXAMINER

VO, TUNG T

ART UNIT PAPER NUMBER

2613

DATE MAILED: 06/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/232,566

Applicant(s)

JANSEN, ROLF

Examiner

Tung Vo

Art Unit

2613

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3 and 4 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 3 and 4 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

1. In view of the newly discovered references, DE 33 16 818, US 6,259,475, and US 6,172,600, PROSECUTION IS HEREBY REOPENED.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Regarding claim 4, line 3, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim 4, line 8, "the ideal position" is indefinite. It is not clear that which position of the camera is mounted. Appropriation correction is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

Art Unit: 2613

such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hans-Hellmut Ernst (DE 33 16 818) in view of Lee (US 5,680,123).

Re claim 3, Ernst teaches an assembly of a camcorder-type crystal display monitor (elements 1-8 of the figure), comprising means (element 7 of figure) for mounting said assembly (elements 1-6 and 8 of the figure) to the inner retracted side of a driver's sun-visor (see the translation of DE 33 16 818, page 4 lines 1-10) a motor vehicle, whereby said sun-visor, when lowered, allows a driver easy, direct, close-range, sunlight-protected viewing of said monitor screen (see the translation of DE 33 16 818, page 4, line 19, page 5, line 2), as if the screen were a rear-view mirror (element 2 of the figure), when used in conjunction with a video phone (element 11 of the figure). Ernst further suggests means of connecting socket (element 6 of the figure) earphones (element 9 of the figure), game-pilot lever 11 or external devices can be connected to provide video telephone signal to the display (element 2 of the figure).

It is noted that Ernst does not particularly teach the screen display, when used in conjunction with a video camera to see to the rear when unaided view is obstructed as claimed.

However, Lee teaches video cameras (62, 64, and 66 of fig. 5), a third video camera (66 of fig. 6) mounted on a rear the vehicle to view an object present in the rear region of the vehicle (C fig. 1a), wherein the rear image is transmitted to a display monitor placed in the front of the vehicle for a driver viewing (74 of fig. 5), so this suggests the screen display, when used in conjunction with a video camera to see to the rear when unaided view is obstructed.

Art Unit: 2613

Therefore, taking the teachings of Ernst and Lee as a whole, it would have been obvious to one of ordinary skill in the art to modify the video cameras (62, 64, and 66 of fig. 6) of Lee into the assembly of the camcorder-type crystal display monitor of Ernst to detect and display objects not readily visible to the vehicle operator.

Doing so would allow the driver to view the hidden object captured by the camera without turning his or her head in the blind spot.

Allowable Subject Matter

7. Claim 4 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

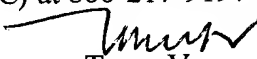
Contact Information


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tung Vo whose telephone number is 571-272-7340. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mehrdad Dastouri can be reached on 571-272-7418. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2613

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Tung Vo
Primary Examiner
Art Unit 2613


ACTING DIRECTOR
TE 2600

Notice of References Cited

Application/Control No.

09/232,566

Applicant(s)/Patent Under

Reexamination
JANSEN, ROLF

Examiner

Tung Vo

Art Unit

2613

Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-6,259,475 B1	07-2001	Ramachandran et al.	348/148
	B	US-6,172,600 B1	01-2001	Kakinami et al.	340/435
	C	US-			
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N	DE 3316818	11-1984	GERMAN	Ernst	B60J 3/00
	O					
	P					
	Q					
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NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

U.S. Patent and Trademark Office, Commerce

amended brief. If appellant does not file an amended brief during the one-month period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will stand dismissed.

(35 U.S.C. 6, Pub. L. 97-247; 15 U.S.C. 1113, 1123)

[36 FR 5850, Mar. 30, 1971, as amended at 53 FR 23734, June 23, 1988; 58 FR 54510, Oct. 22, 1993; 60 FR 14518, Mar. 17, 1995; 62 FR 53196, Oct. 10, 1997]

§1.193 Examiner's answer and reply brief.

(a)(1) The primary examiner may, within such time as may be directed by the Director, furnish a written statement in answer to appellant's brief including such explanation of the invention claimed and of the references and grounds of rejection as may be necessary, supplying a copy to appellant. If the primary examiner finds that the appeal is not regular in form or does not relate to an appealable action, the primary examiner shall so state.

(2) An examiner's answer must not include a new ground of rejection, but if an amendment under §1.116 proposes to add or amend one or more claims and appellant was advised that the amendment under §1.116 would be entered for purposes of appeal and which individual rejection(s) set forth in the action from which the appeal was taken would be used to reject the added or amended claim(s), then the appeal brief must address the rejection(s) of the claim(s) added or amended by the amendment under §1.116 as appellant was so advised and the examiner's answer may include the rejection(s) of the claim(s) added or amended by the amendment under §1.116 as appellant was so advised. The filing of an amendment under §1.116 which is entered for purposes of appeal represents appellant's consent that when so advised any appeal proceed on those claim(s) added or amended by the amendment under §1.116 subject to any rejection set forth in the action from which the appeal was taken.

(b)(1) Appellant may file a reply brief to an examiner's answer or a supplemental examiner's answer within two months from the date of such exam-

iner's answer or supplemental examiner's answer. See §1.136(b) for extensions of time for filing a reply brief in a patent application and §1.550(c) for extensions of time for filing a reply brief in a reexamination proceeding. The primary examiner must either acknowledge receipt and entry of the reply brief or withdraw the final rejection and reopen prosecution to respond to the reply brief. A supplemental examiner's answer is not permitted, unless the application has been remanded by the Board of Patent Appeals and Interferences for such purpose.

(2) Where prosecution is reopened by the primary examiner after an appeal or reply brief has been filed, appellant must exercise one of the following two options to avoid abandonment of the application:

(i) File a reply under §1.111, if the Office action is not final, or a reply under §1.113, if the Office action is final; or

(ii) Request reinstatement of the appeal. If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (§§1.130, 1.131 or 1.132) or other evidence are permitted.

[62 FR 53197, Oct. 10, 1997, as amended at 65 FR 54676, Sept. 8, 2000]

§1.194 Oral hearing.

(a) An oral hearing should be requested only in those circumstances in which appellant considers such a hearing necessary or desirable for a proper presentation of the appeal. An appeal decided without an oral hearing will receive the same consideration by the Board of Patent Appeals and Interferences as appeals decided after oral hearing.

(b) If appellant desires an oral hearing, appellant must file, in a separate paper, a written request for such hearing accompanied by the fee set forth in §1.17(d) within two months from the date of the examiner's answer. If appellant requests an oral hearing and submits therewith the fee set forth in §1.17(d), an oral argument may be presented by, or on behalf of, the primary examiner if considered desirable by either the primary examiner or the Board. See §1.136(b) for extensions of time for requesting an oral hearing in

In the United States Patent and Trademark Office

Appeal No: 2005-0378
Serial No: 09/232,566
Appn. Filed: 01/15/99
Applicant: Rolf Jansen
Appn. Title: Tractor/Trailer Back-up Kit
Examiner/GAU: Tung Vo/2613

Mailed: 9-3-05
At: Houston, Texas

REQUEST FOR REINSTATEMENT OF THE APPEAL

Sir:

Applicant/appellant, Rolf Jansen, pro se, requests reinstatement of his appeal to the Board of Patent Appeals and Interferences, in accordance with 37 CFR Sect 1.193(b)(2)(ii).

This request is appropriate for the following reason:

The Board issued a Decision On Appeal, mailed February 8, 2005, that stated: "The decision of the examiner to reject claims 3 and 4 is reversed."

However, on June 22, 2005, the examiner mailed a new Office Action that again rejected claims 3 and 4, after the Board of Patent Appeals and Interferences had decided the case.

Enclosed is Appellant's 2nd Supplemental Brief, in triplicate, for the purpose of replying to the examiner's Office Action. The appellant encloses herewith check for \$170.00, the small entity fee for filing a brief.

Petition to Make Special, for Reason IV-Applicant is over 65 years of age, was granted 11/27/04. He is now age 72.

Very respectfully,

Rolf Jansen
Rolf Jansen, appellant, pro se
P.O. Box 73161
Houston, Tx 77273-3161

Certificate of Mailing

I certify that this correspondence will be deposited with the United States Postal Service as first class mail with proper postage affixed in an envelope addressed to "Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" on the date below.

Date: 9-3-05

Rolf Jansen

Rolf Jansen, appellant, pro se
P.O. Box 73161
Houston, TX 77273-3161
281-440-6907

U.S. Patent and Trademark Office, Commerce

h. 1 (7-1-04 Edition)

required for a petition. The appropriate fee will so indicate. If the fee does not accompany the petition, the petition will be dismissed.

The petition will not be granted unless it is considered necessary by the Director.

The filing of a petition will not constitute an admission of the applicant's liability for the application, nor will it constitute an admission of the applicant's liability for the proceedings. Any part of the petition not filed with the petition, the mailing date of which is from which relief may be granted, will be dismissed as provided, unless otherwise provided. The period is not extended.

The Director may delegate to an authorized official of the Patent and Trademark Office the termination of a petition.

2. 1959, as amended at 34 FR 41278, Sept. 17, 1969; 47 FR 41278, Sept. 17, 1982; 54 FR 54510, Oct. 22, 1989; 62 FR 53196, Oct. 10, 1997; 65 FR 76774, Dec. 7, 2000]

s not specifically provided.

not specifically provided. Regulations of this part in accordance with the provisions of this section by or under the authority of the Director, subject to the requirements of the Patent and Trademark Office, as may be such decision will be made by the Director. The petition seeking a decision must be accompanied by the fee set forth in § 1.17(h).

10, 1997]

sion of rules.

ordinary situation, when the Director, subject to the requirements of the Patent and Trademark Office, as may be such decision will be made by the Director. The petition seeking a decision must be accompanied by the fee set forth in § 1.17(h). t. 17, 1982]

§ 1.184 [Reserved]

APPEAL TO THE BOARD OF PATENT APPEALS AND INTERFERENCES

AUTHORITY: Secs. 1.191 to 1.198 also issued under 35 U.S.C. 134.

§ 1.191 Appeal to Board of Patent Appeals and Interferences.

(a)(1) Every applicant for a patent or for reissue of a patent, and every owner of a patent involved in an *ex parte* reexamination proceeding filed under § 1.510 before November 29, 1999, any of whose claims has been twice or finally (§ 1.113) rejected, may appeal from the decision of the examiner to the Board of Patent Appeals and Interferences by filing a notice of appeal and the fee set forth in § 1.17(b) within the time period for reply provided under §§ 1.134 and 1.136 (for applications) or § 1.550(c) (for *ex parte* reexamination proceedings).

(2) Every owner of a patent involved in an *ex parte* reexamination proceeding filed under § 1.510 on or after November 29, 1999, any of whose claims has been finally (§ 1.113) rejected, may appeal from the decision of the examiner to the Board of Patent Appeals and Interferences by filing a notice of appeal and the fee set forth in § 1.17(b) within the time period for reply provided under §§ 1.134 and 1.550(c).

(3) Appeals to the Board of Patent Appeals and Interferences in *inter partes* reexamination proceedings filed under § 1.913 are controlled by §§ 1.959 through 1.981. Sections 1.191 through 1.198 are not applicable to appeals in *inter partes* reexamination proceedings filed under § 1.913.

(b) The signature requirement of § 1.33 does not apply to a notice of appeal filed under this section.

(c) An appeal when taken must be taken from the rejection of all claims under rejection which the applicant or patent owner proposes to contest. Questions relating to matters not affecting the merits of the invention may be required to be settled before an appeal can be considered.

(d) The time periods set forth in §§ 1.191 and 1.192 are subject to the provisions of § 1.136 for patent applications and § 1.550(c) for reexamination proceedings. The time periods set forth in

§§ 1.193, 1.194, 1.196 and 1.197 are subject to the provisions of § 1.136(b) for patent applications or § 1.550(c) for reexamination proceedings. See § 1.304(a) for extensions of time for filing a notice of appeal to the U.S. Court of Appeals for the Federal Circuit or for commencing a civil action.

(e) Jurisdiction over the application or patent under reexamination passes to the Board of Patent Appeals and Interferences upon transmittal of the file, including all briefs and examiner's answers, to the Board. Prior to the entry of a decision on the appeal, the Director may sua sponte order the application remanded to the examiner.

(35 U.S.C. 6, Pub. L. 97-247; 15 U.S.C. 1113, 1123)

[46 FR 29183, May 29, 1981, as amended at 49 FR 555, Jan. 4, 1984; 49 FR 48453, Dec. 12, 1984; 54 FR 29552, July 13, 1989; 58 FR 54510, Oct. 22, 1993; 62 FR 53196, Oct. 10, 1997; 65 FR 76774, Dec. 7, 2000; 68 FR 71006, Dec. 22, 2003]

§ 1.192 Appellant's brief.

(a) Appellant must, within two months from the date of the notice of appeal under § 1.191 or within the time allowed for reply to the action from which the appeal was taken, if such time is later, file a brief in triplicate. The brief must be accompanied by the fee set forth in § 1.17(c) and must set forth the authorities and arguments on which appellant will rely to maintain the appeal. Any arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences, unless good cause is shown.

(b) On failure to file the brief, accompanied by the requisite fee, within the time allowed, the appeal shall stand dismissed.

(c) The brief shall contain the following items under appropriate headings and in the order indicated below unless the brief is filed by an applicant who is not represented by a registered practitioner:

(1) *Real party in interest.* A statement identifying the real party in interest, if the party named in the caption of the brief is not the real party in interest.

(2) *Related appeals and interferences.* A Statement identifying by number and



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/232,566	01/15/1999	ROLF JANSEN		1686

7590

06/16/2006

ROLF JANSEN
P O BOX 73161
HOUSTON, TX 77273

EXAMINER

ART UNIT PAPER NUMBER

DATE MAILED: 06/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

EXHIBIT 5

2 PAGES

**Notification of Non-Compliant Appeal Brief
(37 CFR 41.37)**

Application No.

09/232,566

Applicant(s)

JANSEN, ROLF

Examiner

Tung Vo

Art Unit

2621

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The Appeal Brief filed on 09/08/06 is defective for failure to comply with one or more provisions of 37 CFR 41.37.

To avoid dismissal of the appeal, applicant must file an amended brief or other appropriate correction (see MPEP 1205.03) within **ONE MONTH or THIRTY DAYS** from the mailing date of this Notification, whichever is longer.

EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136.

1. ☒ The brief does not contain the items required under 37 CFR 41.37(c), or the items are not under the proper heading or in the proper order.
2. ☐ The brief does not contain a statement of the status of all claims, (e.g., rejected, allowed, withdrawn, objected to, canceled), or does not identify the appealed claims (37 CFR 41.37(c)(1)(iii)).
3. ☐ At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 41.37(c)(1)(iv)).
4. ☐ (a) The brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)).
5. ☐ The brief does not contain a concise statement of each ground of rejection presented for review (37 CFR 41.37(c)(1)(vi)).
6. ☐ The brief does not present an argument under a separate heading for each ground of rejection on appeal (37 CFR 41.37(c)(1)(vii)).
7. ☐ The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 41.37(c)(1)(viii)).
8. ☐ The brief does not contain copies of the evidence submitted under 37 CFR 1.130, 1.131, or 1.132 or of any other evidence entered by the examiner **and relied upon by appellant in the appeal**, along with a statement setting forth where in the record that evidence was entered by the examiner, as an appendix thereto (37 CFR 41.37(c)(1)(ix)).
9. ☒ The brief does not contain copies of the decisions rendered by a court or the Board in the proceeding identified in the Related Appeals and Interferences section of the brief as an appendix thereto (37 CFR 41.37(c)(1)(x)).
10. ☐ Other (including any explanation in support of the above items):



Tung Vo
Primary Examiner
Art Unit: 2621

EXHIBIT 6

§41.33

2 PAGES

37 CFR Ch. I (7-1-05 Edition)

U.S. Patent and

(d) The time periods set forth in paragraphs (a)(1) through (a)(3) of this section are extendable under the provisions of §1.136 of this title for patent applications and §1.550(c) of this title for *ex parte* reexamination proceedings.

§41.33 Amendments and affidavits or other evidence after appeal.

(a) Amendments filed after the date of filing an appeal pursuant to §41.31(a)(1) through (a)(3) and prior to the date a brief is filed pursuant to §41.37 may be admitted as provided in §1.116 of this title.

(b) Amendments filed on or after the date of filing a brief pursuant to §41.37 may be admitted:

(1) To cancel claims, where such cancellation does not affect the scope of any other pending claim in the proceeding, or

(2) To rewrite dependent claims into independent form.

(c) All other amendments filed after the date of filing an appeal pursuant to §41.31(a)(1) through (a)(3) will not be admitted except as permitted by §§41.39(b)(1), 41.50(a)(2)(i), 41.50(b)(1) and 41.50(c).

(d)(1) An affidavit or other evidence filed after the date of filing an appeal pursuant to §41.31(a)(1) through (a)(3) and prior to the date of filing a brief pursuant to §41.37 may be admitted if the examiner determines that the affidavit or other evidence overcomes all rejections under appeal and that a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented has been made.

(2) All other affidavits or other evidence filed after the date of filing an appeal pursuant to §41.31(a)(1) through (a)(3) will not be admitted except as permitted by §§41.39(b)(1), 41.50(a)(2)(i) and 41.50(b)(1).

§41.35 Jurisdiction over appeal.

(a) Jurisdiction over the proceeding passes to the Board upon transmittal of the file, including all briefs and examiner's answers, to the Board.

(b) If, after receipt and review of the proceeding, the Board determines that the file is not complete or is not in compliance with the requirements of this subpart, the Board may relinquish

jurisdiction to the examiner or take other appropriate action to permit completion of the file.

(c) Prior to the entry of a decision on the appeal by the Board, the Director may sua sponte order the proceeding remanded to the examiner.

§41.37 Appeal brief.

(a)(1) Appellant must file a brief under this section within two months from the date of filing the notice of appeal under §41.31.

(2) The brief must be accompanied by the fee set forth in §41.20(b)(2).

(b) On failure to file the brief, accompanied by the requisite fee, within the period specified in paragraph (a) of this section, the appeal will stand dismissed.

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(i) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

(i) *Real party in interest.* A statement identifying by name the real party in interest.

(ii) *Related appeals and interferences.* A statement identifying by application, patent, appeal or interference number all other prior and pending appeals, interferences or judicial proceedings known to appellant, the appellant's legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal. Copies of any decisions rendered by a court or the Board in any proceeding identified under this paragraph must be included in an appendix as required by paragraph (c)(1)(x) of this section.

(iii) *Status of claims.* A statement of the status of all the claims in the proceeding (*e.g.*, rejected, allowed or confirmed, withdrawn, objected to, canceled) and an identification of those claims that are being appealed.

(iv) *Status of amendments.* A statement of the status of any amendment filed subsequent to final rejection.

(v) *Summary*

A concise explanation of the matter defining independent claim which shall run by page and drawing, if a characters. For each involved in the independent claim the provisions of this section and step must be graph, must structure, must in the specific each claimed forth with ref by page the drawing, characters.

(vi) *Grounds on appeal.* A ground of rejection.

(vii) *Argument.* Appellant with rejection present graph (c)(1)(vi) basis therefor. statutes, regulations, parts of the regulations or amendments or authority the brief or a reference to §41.41 will be by the Board. shown. Each ground be treated under For each ground to two or more be argued separately. When multiple same ground of a group by appellant select a single claims that are decide the appeal group of claims rejection on the claim alone. other provisions failure of appeal claims which together shall consider the patent claim separate separately shown

(v) *Summary of claimed subject matter.* A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

(vi) *Grounds of rejection to be reviewed on appeal.* A concise statement of each ground of rejection presented for review.

(vii) *Argument.* The contentions of appellant with respect to each ground of rejection presented for review in paragraph (c)(1)(vi) of this section, and the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on. Any arguments or authorities not included in the brief or a reply brief filed pursuant to § 41.41 will be refused consideration by the Board, unless good cause is shown. Each ground of rejection must be treated under a separate heading. For each ground of rejection applying to two or more claims, the claims may be argued separately or as a group. When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately. Any claim argued separately should be placed under a

subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number. A statement which merely points out what a claim recites will not be considered an argument for separate patentability of the claim.

(viii) *Claims appendix.* An appendix containing a copy of the claims involved in the appeal.

(ix) *Evidence appendix.* An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

(x) *Related proceedings appendix.* An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

(2) A brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See § 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and § 41.33 for amendments, affidavits or other evidence filed after the date of filing the appeal.

(d) If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will stand dismissed.

(e) The time periods set forth in this section are extendable under the provisions of § 1.136 of this title for patent applications and § 1.550(c) of this title for *ex parte* reexamination proceedings.

§ 1.136(b) for extensions of time for seeking rehearing in a patent application and § 1.550(c) for extensions of time for seeking rehearing in a reexamination proceeding.

The term "rehearing" is used in 37 CFR 1.197(b) for consistency with the language of 35 U.S.C. 6(b). It should not be interpreted as meaning that an appellant is entitled to an oral hearing on the request for rehearing, but only to a rehearing on the written record. It is not the normal practice of the Board to grant rehearings in the sense of another oral hearing. *Ex parte Argoudelis*, 157 USPQ 437, 441 (Bd. App. 1967), *rev'd. on other grounds*, 434 F.2d 1390, 168 USPQ 99 (CCPA 1970).

37 CFR 1.197(b) provides that any request for rehearing must specifically state the points believed to have been misapprehended or overlooked in the Board's decision. Experience has shown that many requests for rehearing are nothing more than reargument of appellant's position on appeal. In response, the rule was revised to limit requests to the points of law or fact which appellant feels were overlooked or misapprehended by the Board.

The 2-month period provided by 37 CFR 1.197(b) for filing a request for rehearing can only be extended under the provisions of 37 CFR 1.136(b) or under 37 CFR 1.550(c) if the appeal involves an *ex parte* reexamination proceeding.

All copies of references in the file wrapper should be retained therein.

For extension of time to appeal to the Court of Appeals for the Federal Circuit or commence a civil action under 37 CFR 1.304(a), see MPEP § 1216 and § 1002.02(o).

For requests for reconsideration by the examiner, see MPEP § 1214.04.

1214.04 Examiner Reversed

A complete reversal of the examiner's rejection brings the case up for immediate action by the examiner. If the reversal does not place an application in condition for immediate allowance (e.g., the Board has entered a new ground of rejection under 37 CFR 1.196(b)), the examiner should refer to the situations outlined in MPEP § 1214.06 for appropriate guidance.

The examiner should never regard such a reversal as a challenge to make a new search to uncover other and better references. This is particularly so where the application or *ex parte* reexamination proceeding has meanwhile been transferred or assigned to an examiner other than the one who rejected the claims leading to the appeal. The second examiner should give full faith and credit to the prior examiner's search.

If the examiner has specific knowledge of the existence of a particular reference or references which indicate nonpatentability of any of the appealed claims as to which the examiner was reversed, he or she should submit the matter to the Technology Center (TC) Director for authorization to reopen prosecution under 37 CFR 1.198 for the purpose of entering the new rejection. See MPEP § 1002.02(c) and MPEP § 1214.07. The TC Director's approval is placed on the action reopening prosecution.

The examiner may request rehearing of the Board decision. Such a request should normally be made within 2 months of the receipt of the Board decision in the TC. The TC Director's secretary should therefore date stamp all Board decisions upon receipt in the TC.

All requests by the examiner to the Board for rehearing of a decision must be approved by the TC Director and must also be forwarded to the Office of the Deputy Commissioner for Patent Examination Policy for approval before mailing.

The request should set a period of 1 month for the appellant to file a reply.

If approved, the Office of the Deputy Commissioner for Patent Examination Policy will mail a copy of the request for rehearing to the appellant. After the period set for appellant to file a reply (plus mailing time) has expired, the application file will be forwarded to the Board.

1214.05 Cancellation of Withdrawn Claims

Where an appellant withdraws some of the appealed claims, and the Board reverses the examiner on the remaining appealed claims, the withdrawal is treated as an authorization to cancel the withdrawn claims. It is not necessary to notify the appellant of the cancellation of the withdrawn claims.

Office Action Summary

Application No.

09/232,566

Applicant(s)

JANSEN, ROLF

Examiner

Tung T. Vo

Art Unit

2613

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status*EXHIBIT 9**5 PAGES*

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 3 and 4 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 3 and 4 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

DETAILED ACTION

Drawings

The corrected or substitute drawings were received on 9/6/00. These drawings are approval.

Response to Arguments

1. Applicant's arguments with respect to claims 3 and 4 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over King (US 5,971,468) in view of Frankhouse et al. (US 5,940,120).

Re claim 3, King discloses an assembly of a camcorder-type liquid crystal display monitor (26 of fig. 1) is mounted to the inner retracted side of a driver sunvisor (24 of fig. 1) of a vehicle (20 of fig. 1) when the sunvisor is lowered allows a driver easily direct, close-range, sunlight-protected viewing of the monitor screen, the display monitor is connected to a navigation system to display a navigation information.

It is noted that King discloses the display monitor is connected to the navigation system but King fails to particularly connect to a video camera to see to the rear when the unaided view

Art Unit: 2613

is obstructed. However, Frankhouse teaches a LCD display (90 of fig. 6) is mounted to the compartment (124 of fig. 6) of the vehicle to display information of a rear view captured by a video camera (96 of fig. 10). Taking the teachings of King and Frankhouse together as a whole, it would have been obvious to one of ordinary skill in the art to modify the camera (96) of Frankhouse into the system of King for the same purpose of capturing a angle rear view of traffic or objects behind the vehicle. Doing would allow the driver see a various locations around vehicle without turning his/her head around.

3. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Aberfelder et al. (US 5,646,614).

Re claim 4, Abersfelder discloses a camera (11 of fig. 1) is built in and located on the back of a car (10 of fig. 1), whereby said camera is located in the ideal at rear of the car for viewing a backing and connected to a monitor (15 of fig. 1), and wide angle lenses are used in this particular camera to receive a wide view image. It is noted that Abersfelder fails to particularly disclose the camera is mounted on the reverse side of a license plate at the rear of vehicle so that the camera can see through a predetermined-sized whole put in the license plate. However, it is well established that one skilled in the art would have obvious to mount the camera anywhere on the car, particularly on the reverse side of a license plate at the rear of the vehicle, and the camera can see through a predetermined-sized hole put in the license plate a rear view when the vehicle is backing.

Abersfelder further teaches any conventional and suitable camera lenses, camera lenses of very compact construction can be used, without the requirement of extending the camera purposes of realizing a sufficient viewing angle (col. 2, lines 16-25). However, Abersfelder does

Art Unit: 2613

not particularly disclose a pin hole lens which is used for a camera. Aviv teaches a pin hole lens is used for a camera (col. 9, lines 54-65). Taking the teachings of Abersfelder et al and Aviv together as a whole, it would have been obvious to one of ordinary skill in the art to modify the pin hole lens of Aviv into the system of Abersfelder for the same purpose of seeing through the predetermined sized hole of license plate.

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Contact Information

Art Unit: 2613

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tung T. Vo whose telephone number is (703) 308-5874. The examiner can normally be reached on M-F 7:30AM-4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (703) 305-4856. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-6306 for regular communications and (703) 308-6306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

Tung T. Vo
Examiner
Art Unit 2613

T.vo.
January 23, 2001


CHRIS KELLEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

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erences or grounds of rejection.

(d) The Board of Patent Appeals and Interferences may require appellant to address any matter that is deemed appropriate for a reasoned decision on the pending appeal. Appellant will be given a non-extendable time period within which to respond to such a requirement.

(e) Whenever a decision of the Board of Patent Appeals and Interferences includes or allows a remand, that decision shall not be considered a final decision. When appropriate, upon conclusion of proceedings on remand before the examiner, the Board of Patent Appeals and Interferences may enter an order otherwise making its decision final.

(f) See §1.136(b) for extensions of time to take action under this section in a patent application and §1.550(c) for extensions of time in a reexamination proceeding.

[49 FR 48453, Dec. 12, 1984, as amended at 54 FR 29552, July 13, 1989; 58 FR 54510, Oct. 22, 1993; 62 FR 53197, Oct. 10, 1997]

§1.197 Action following decision.

(a) After decision by the Board of Patent Appeals and Interferences, the application will be returned to the examiner, subject to appellant's right of appeal or other review, for such further action by appellant or by the examiner, as the condition of the application may require, to carry into effect the decision.

(b) Appellant may file a single request for rehearing within two months from the date of the original decision, unless the original decision is so modified by the decision on rehearing as to become, in effect, a new decision, and the Board of Patent Appeals and Interferences so states. The request for rehearing must state with particularity the points believed to have been misapprehended or overlooked in rendering the decision and also state all other grounds upon which rehearing is sought. See §1.136(b) for extensions of time for seeking rehearing in a patent application and §1.550(c) for extensions of time for seeking rehearing in a reexamination proceeding.

(c) Termination of proceedings. (1) Proceedings are considered terminated by the dismissal of an appeal or the failure to timely file an appeal to the court or a civil action (§1.304) except:

(i) Where claims stand allowed in an application; or

(ii) Where the nature of the decision requires further action by the examiner.

(2) The date of termination of proceedings is the date on which the appeal is dismissed or the date on which the time for appeal to the Court or review by civil action (§1.304) expires. If an appeal to the Court or a civil action has been filed, proceedings are considered terminated when the appeal or civil action is terminated. An appeal to the U.S. Court of Appeals for the Federal Circuit is terminated when the mandate is issued by the Court. A civil action is terminated when the time to appeal the judgment expires.

The date of termination of proceedings is the date on which the appeal is dismissed or the date on which the time for appeal to the court or review by civil action (§1.304) expires. If an appeal to the court or a civil action has been filed, proceedings are considered terminated when the appeal or civil action is terminated. An appeal to the U.S. Court of Appeals for the Federal Circuit is terminated when the mandate is received by the Office. A civil action is terminated when the time to appeal the judgment expires.

(35 U.S.C. 6, Pub. L. 97-247; 15 U.S.C. 1113, 1123)

[46 FR 29184, May 29, 1981, as amended at 49 FR 48453, Dec. 12, 1984; 54 FR 29552, July 13, 1989; 58 FR 54510, Oct. 22, 1993; 62 FR 53198, Oct. 10, 1997; 68 FR 71006, Dec. 22, 2003]

§1.198 Reopening after decision.

Cases which have been decided by the Board of Patent Appeals and Interferences will not be reopened or reconsidered by the primary examiner except under the provisions of §1.114 or §1.196 without the written authority of the Director, and then only for the consideration of matters not already adjudicated, sufficient cause being shown.

[65 FR 14873, Mar. 20, 2000]

a patent application and § 1.550(c) for extensions of time for requesting an oral hearing in a reexamination proceeding.

(c) If no request and fee for oral hearing have been timely filed by appellant, the appeal will be assigned for consideration and decision. If appellant has requested an oral hearing and has submitted the fee set forth in § 1.17(d), a day of hearing will be set, and due notice thereof given to appellant and to the primary examiner. A hearing will be held as stated in the notice, and oral argument will be limited to twenty minutes for appellant and fifteen minutes for the primary examiner unless otherwise ordered before the hearing begins. If the Board decides that a hearing is not necessary, the Board will so notify appellant.

[62 FR 53197, Oct. 10, 1997]

§ 1.195 Affidavits or declarations after appeal.

Affidavits, declarations, or exhibits submitted after the case has been appealed will not be admitted without a showing of good and sufficient reasons why they were not earlier presented.

[34 FR 18858, Nov. 26, 1969]

§ 1.196 Decision by the Board of Patent Appeals and Interferences.

(a) The Board of Patent Appeals and Interferences, in its decision, may affirm or reverse the decision of the examiner in whole or in part on the grounds and on the claims specified by the examiner or remand the application to the examiner for further consideration. The affirmance of the rejection of a claim on any of the grounds specified constitutes a general affirmance of the decision of the examiner on that claim, except as to any ground specifically reversed.

(b) Should the Board of Patent Appeals and Interferences have knowledge of any grounds not involved in the appeal for rejecting any pending claim, it may include in the decision a statement to that effect with its reasons for so holding, which statement constitutes a new ground of rejection of the claim. A new ground of rejection shall not be considered final for purposes of judicial review. When the

Board of Patent Appeals and Interferences makes a new ground of rejection, the appellant, within two months from the date of the decision, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. The new ground of rejection is binding upon the examiner unless an amendment or showing of facts not previously of record be made which, in the opinion of the examiner, overcomes the new ground of rejection stated in the decision. Should the examiner reject the claims, appellant may again appeal pursuant to §§ 1.191 through 1.195 to the Board of Patent Appeals and Interferences.

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. The request for rehearing must address the new ground of rejection and state with particularity the points believed to have been misapprehended or overlooked in rendering the decision and also state all other grounds upon which rehearing is sought. Where request for such rehearing is made, the Board of Patent Appeals and Interferences shall rehear the new ground of rejection and, if necessary, render a new decision which shall include all grounds of rejection upon which a patent is refused. The decision on rehearing is deemed to incorporate the earlier decision for purposes of appeal, except for those portions specifically withdrawn on rehearing, and is final for the purpose of judicial review, except when noted otherwise in the decision.

(c) Should the decision of the Board of Patent Appeals and Interferences include an explicit statement that a claim may be allowed in amended form, appellant shall have the right to

action indicates that it is made final (§ 1.113) or an appeal (§ 1.191) has been taken (§ 1.116), or in an *inter partes* reexamination, that it is an action closing prosecution (§ 1.949) or a right of appeal notice (§ 1.953).

[65 FR 76773, Dec. 7, 2000]

§ 1.113 Final rejection or action.

(a) On the second or any subsequent examination or consideration by the examiner the rejection or other action may be made final, whereupon applicant's, or for *ex parte* reexaminations filed under § 1.510, patent owner's reply is limited to appeal in the case of rejection of any claim (§ 1.191), or to amendment as specified in § 1.114 or § 1.116. Petition may be taken to the Commissioner in the case of objections or requirements not involved in the rejection of any claim (§ 1.181). Reply to a final rejection or action must comply with § 1.114 or paragraph (c) of this section. For final actions in an *inter partes* reexamination filed under § 1.913, see § 1.953.

(b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the application, clearly stating the reasons in support thereof.

(c) Reply to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the reply to a final rejection or action must comply with any requirements or objections as to form.

[65 FR 14872, Mar. 20, 2000, as amended at 65 FR 76773, Dec. 7, 2000]

§ 1.114 Request for continued examination.

(a) If prosecution in an application is closed, an applicant may request continued examination of the application by filing a submission and the fee set forth in § 1.17(e) prior to the earliest of:

(1) Payment of the issue fee, unless a petition under § 1.313 is granted;

(2) Abandonment of the application; or

(3) The filing of a notice of appeal to the U.S. Court of Appeals for the Federal Circuit under 35 U.S.C. 141, or the commencement of a civil action under

35 U.S.C. 145 or 146, unless the appeal or civil action is terminated.

(b) Prosecution in an application is closed as used in this section means that the application is under appeal, or that the last Office action is a final action (§ 1.113), a notice of allowance (§ 1.311), or an action that otherwise closes prosecution in the application.

(c) A submission as used in this section includes, but is not limited to, an information disclosure statement, an amendment to the written description, claims, or drawings, new arguments, or new evidence in support of patentability. If reply to an Office action under 35 U.S.C. 132 is outstanding, the submission must meet the reply requirements of § 1.111.

(d) If an applicant timely files a submission and fee set forth in § 1.17(e), the Office will withdraw the finality of any Office action and the submission will be entered and considered. If an applicant files a request for continued examination under this section after appeal, but prior to a decision on the appeal, it will be treated as a request to withdraw the appeal and to reopen prosecution of the application before the examiner. An appeal brief under § 1.192 or a reply brief under § 1.193(b), or related papers, will not be considered a submission under this section.

(e) The provisions of this section do not apply to:

(1) A provisional application;

(2) An application for a utility or plant patent filed under 35 U.S.C. 111(a) before June 8, 1995;

(3) An international application filed under 35 U.S.C. 363 before June 8, 1995;

(4) An application for a design patent; or

(5) A patent under reexamination.

[65 FR 50104, Aug. 16, 2000]

AMENDMENTS

AUTHORITY: Secs. 1.115 to 1.127 also issued under 35 U.S.C. 132.

§ 1.115 Preliminary amendments.

(a) A preliminary amendment is an amendment that is received in the Office (§ 1.6) on or before the mail date of the first Office action under § 1.104.

(b)(1) A preliminary amendment will be entered unless disapproved by the

of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire. Examiners are encouraged to suggest claim language to applicants to improve the clarity or precision of the language used, but should not reject claims or insist on their own preferences if other modes of expression selected by applicants satisfy the statutory requirement.

The essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed, not in a vacuum, but in light of:

(A) The content of the particular application disclosure;

(B) The teachings of the prior art; and

(C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.

In reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph >by providing clear warning to others as to what constitutes infringement of the patent<. See, e.g., *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000). See also *In re Larsen*, No. 01-1092 (Fed. Cir. May 9, 2001) (unpublished) (The preamble of the *Larsen* claim recited only a hanger and a loop but the body of the claim positively recited a linear member. The court observed that the totality of all the limitations of the claim and their interaction with each other must be considered to ascertain the inventor's contribution to the art. Upon review of the claim in its entirety, the court concluded that the claim at issue apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112 paragraph 2.).

>If the language of the claim is such that a person of ordinary skill in the art could not interpret the metes and bounds of the claim so as to understand how to avoid infringement, a rejection of the claim under 35 U.S.C. 112, second paragraph would be appropriate. See *Morton Int'l, Inc. v. Cardinal Chem. Co.*, 5 F.3d 1464, 1470, 28 USPQ2d 1190, 1195 (Fed.

Cir. 1993). However, if the language used by applicant satisfies the statutory requirements of 35 U.S.C. 112, second paragraph, but the examiner merely wants the applicant to improve the clarity or precision of the language used, the claim must not be rejected under 35 U.S.C. 112, second paragraph, rather, the examiner should suggest improved language to the applicant.

For example, a claim recites "a suitable liquid such as the filtrate of the contaminated liquid to be filtered and solids of a filtering agent such as perlite, cellulose powder, etc." The mere use of the phrase "such as" in the claim does not by itself render the claim indefinite. Office policy is not to employ per se rules to make technical rejections. Examples of claim language which have been held to be indefinite set forth in MPEP § 2173.05(d) are fact specific and should not be applied as per se rules. The test for definiteness under 35 U.S.C. 112, second paragraph is whether "those skilled in the art would understand what is claimed when the claim is read in light of the specification." *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576, 1 USPQ2d 1081, 1088 (Fed. Cir. 1986). If one skilled in the art is able to ascertain in the example above, the meaning of the terms "suitable liquid" and "solids of a filtering agent" in light of the specification, 35 U.S.C. 112, second paragraph is satisfied. If upon review of the claim as a whole in light of the specification, the examiner determines that a rejection under 35 U.S.C. 112, second paragraph is not appropriate in the above-noted example, but is of the opinion that the clarity and the precision of the language can be improved by the deletion of the phrase "such as" in the claim, the examiner may make such a suggestion to the applicant. If applicant does not accept the examiner's suggestion, the examiner should not pursue the issue.

If upon review of a claim in its entirety, the examiner concludes that a rejection under 35 U.S.C. 112, second paragraph is appropriate, such a rejection should be made and an analysis as to why the phrase(s) used in the claim is "vague and indefinite" should be included in the Office action. If applicants traverse the rejection, with or without the submission of an amendment, and the examiner considers applicant's arguments to be persuasive, the examiner should indicate in the next Office communication that the previous rejection under 35 U.S.C. 112, second

535 U.S. 722, 122 S.Ct. 1831, 152 L.Ed.2d 944, 70 USLW 4458, 62 U.S.P.Q.2d 1705, 02 Cal. Daily Op. Serv. 4539, 2002 Daily Journal D.A.R. 5803, 15 Fla. L. Weekly Fed. S 320

Briefs and Other Related Documents

EXHIBIT 11

12 PAGES

Supreme Court of the United States
FESTO CORPORATION, Petitioner,
v.
SHOKETSU KINZOKU KOGYO KABUSHIKI CO., LTD., et al.
No. 00-1543.
Argued Jan. 8, 2002.
Decided May 28, 2002.

Holder of two patents relating to magnetic rodless cylinders sued competitor for infringement. The United States District Court for the District of Massachusetts, Patti B. Saris, J., held for plaintiff, and competitor appealed. The Court of Appeals, 72 F.3d 857, affirmed. On grant of writ of certiorari, the Supreme Court, 520 U.S. 1111, 117 S.Ct. 1240, 137 L.Ed.2d 323, vacated and remanded. On remand, the Court of Appeals initially affirmed in part, vacated in part, and remanded, 172 F.3d 1361, but on rehearing en banc, 187 F.3d 1381, reversed. Certiorari was granted. The Supreme Court, Justice Kennedy, held that: (1) prosecution history estoppel may apply to any claim amendment made to satisfy Patent Act's requirements; (2) amendment is not absolute bar to claim of infringement under doctrine of equivalents; and (3) patentee has burden of proving that amendment did not surrender particular equivalent in question.

Vacated and remanded.

West Headnotes

[1] KeyCite this headnote

291 Patents
291X Title, Conveyances, and Contracts
291X(A) Rights of Patentees in General
291k184 Exclusive Nature of Right
291k185 k. In General. Most Cited Cases

Patent holder's temporary monopoly is property right.

[2] KeyCite this headnote

291 Patents
291XII Infringement
291XII(A) What Constitutes Infringement
291k233 Patents for Machines or Manufactures
291k237 k. Substitution of Equivalents. Most Cited Cases

Scope of patent is not limited to its literal terms but instead embraces all equivalents to claims described.

[3] KeyCite this headnote

291 Patents
291IX Construction and Operation of Letters Patent
291IX(B) Limitation of Claims
291k168 Proceedings in Patent Office in General
291k168(2) Rejection and Amendment of Claims
291k168(2.1) k. In General. Most Cited Cases

Prosecution history estoppel requires that claims of patent be interpreted in light of proceedings in patent Office during application process.

[4] KeyCite this headnote

291 Patents
291IX Construction and Operation of Letters Patent

- ↪ 291IX(B) Limitation of Claims
- ↪ 291k168 Proceedings in Patent Office in General
- ↪ 291k168(2) Rejection and Amendment of Claims
- ↪ 291k168(2.1) k. In General. Most Cited Cases

When patentee originally claimed subject matter alleged to infringe but then narrowed claim in response to patent examiner's rejection, he may not argue that surrendered territory comprised unforeseen subject matter that should be deemed equivalent to literal claims of issued patent.

[5] KeyCite this headnote

- ↪ 291 Patents
- ↪ 291IX Construction and Operation of Letters Patent
- ↪ 291IX(B) Limitation of Claims
- ↪ 291k168 Proceedings in Patent Office in General
- ↪ 291k168(2) Rejection and Amendment of Claims
- ↪ 291k168(2.1) k. In General. Most Cited Cases

Prosecution history estoppel may apply to any claim amendment made to satisfy Patent Act's requirements, not just to amendments made to avoid prior art. 35 U.S.C.A. §§ 101-103, 112.

[6] KeyCite this headnote

- ↪ 291 Patents
- ↪ 291IX Construction and Operation of Letters Patent
- ↪ 291IX(B) Limitation of Claims
- ↪ 291k168 Proceedings in Patent Office in General
- ↪ 291k168(2) Rejection and Amendment of Claims
- ↪ 291k168(2.1) k. In General. Most Cited Cases

- ↪ 291 Patents KeyCite this headnote
- ↪ 291XII Infringement
- ↪ 291XII(A) What Constitutes Infringement
- ↪ 291k233 Patents for Machines or Manufactures
- ↪ 291k237 k. Substitution of Equivalents. Most Cited Cases

Amendment to patent application is not absolute bar to subsequent claim of infringement under doctrine of equivalents.

[7] KeyCite this headnote

- ↪ 291 Patents
- ↪ 291IX Construction and Operation of Letters Patent
- ↪ 291IX(B) Limitation of Claims
- ↪ 291k168 Proceedings in Patent Office in General
- ↪ 291k168(2) Rejection and Amendment of Claims
- ↪ 291k168(2.1) k. In General. Most Cited Cases

- ↪ 291 Patents KeyCite this headnote
- ↪ 291XII Infringement
- ↪ 291XII(A) What Constitutes Infringement
- ↪ 291k233 Patents for Machines or Manufactures
- ↪ 291k237 k. Substitution of Equivalents. Most Cited Cases

Patent applicant's narrowing amendment of claim in response to examiner objection is concession that patent does not extend as far as original claim, but not that amended claim is so perfect in its description that no one could devise equivalent.

[8] KeyCite this headnote

- ↪ 291 Patents

- ↪ 291IX Construction and Operation of Letters Patent
- ↪ 291IX(B) Limitation of Claims
- ↪ 291k168 Proceedings in Patent Office in General
- ↪ 291k168(2) Rejection and Amendment of Claims
- ↪ 291k168(2.1) k. In General. Most Cited Cases

- ↪ 291 Patents KeyCite this headnote
- ↪ 291XII Infringement
- ↪ 291XII(A) What Constitutes Infringement
- ↪ 291k233 Patents for Machines or Manufactures
- ↪ 291k237 k. Substitution of Equivalents. Most Cited Cases

Whether amendment of patent claim in response to examiner objection bars subsequent infringement claim based on doctrine of equivalents requires examination of nature of subject matter surrendered by narrowing amendment.

[9] KeyCite this headnote

- ↪ 291 Patents
- ↪ 291XII Infringement
- ↪ 291XII(C) Suits in Equity
- ↪ 291k312 Evidence
- ↪ 291k312(1) Presumptions and Burden of Proof
- ↪ 291k312(1.1) k. In General. Most Cited Cases

✓ Patentee alleging infringement under doctrine of equivalents has burden of proving that narrowing amendment made during patent prosecution did not surrender particular equivalent in question.

[10] KeyCite this headnote

- ↪ 291 Patents
- ↪ 291XII Infringement
- ↪ 291XII(C) Suits in Equity
- ↪ 291k312 Evidence
- ↪ 291k312(1) Presumptions and Burden of Proof
- ↪ 291k312(1.1) k. In General. Most Cited Cases

Patent applicant's decision to narrow his claims through amendment may be presumed to be general disclaimer of territory between original claim and amended claim.

[11] KeyCite this headnote

- ↪ 291 Patents
- ↪ 291XII Infringement
- ↪ 291XII(C) Suits in Equity
- ↪ 291k312 Evidence
- ↪ 291k312(1) Presumptions and Burden of Proof
- ↪ 291k312(1.1) k. In General. Most Cited Cases

Patentee alleging infringement under doctrine of equivalents can rebut presumption that prosecution history estoppel bars finding of equivalence by showing that at time of amendment one skilled in art could not reasonably be expected to have drafted claim that would have literally encompassed alleged equivalent.

****1832 *722 Syllabus [FN*]**

FN* The syllabus constitutes no part of the opinion of the Court but has been prepared by the Reporter of Decisions for the convenience of the reader. See United States v. Detroit Timber & Lumber Co., 200 U.S. 321, 337, 26 S.Ct. 282, 50 L.Ed. 499.

Petitioner Festo Corporation owns two patents for an industrial device. When the patent examiner rejected the initial

application for the first patent because of defects in description, 35 U.S.C. § 112, the application was amended to add the new limitations that the device would contain a pair of one-way sealing rings and that its outer sleeve would be made of a magnetizable material. The second patent was also amended during a reexamination proceeding to add the sealing rings limitation. After Festo began selling its device, respondents (hereinafter SMC) entered the market with a similar device that uses one two-way sealing ring and a nonmagnetizable sleeve. Festo filed suit, claiming that SMC's device is so similar that it infringes Festo's patents under the doctrine of equivalents. The District Court ruled for Festo, rejecting SMC's argument that the prosecution history estopped Festo from saying that SMC's device is equivalent. A Federal Circuit panel initially affirmed, but this Court granted certiorari, vacated, and remanded in light of *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 29, 117 S.Ct. 1040, 137 L.Ed.2d 146, which had acknowledged that competitors may rely on the prosecution history to estop the patentee from recapturing subject matter surrendered by amendment as a condition of obtaining the patent. On remand, the en banc Federal Circuit reversed, holding that prosecution history estoppel applied. The court ruled that estoppel arises from any amendment that narrows a claim to comply with the Patent Act, not only from amendments made to avoid the prior art, as the District Court had held. The Federal Circuit also held that, when estoppel applies, it bars any claim of equivalence for the element that was amended. The court acknowledged that, under its prior cases, prosecution history estoppel constituted a flexible bar, foreclosing some, but not all, claims of equivalence, depending on the purpose of the amendment and the alterations in the text. However, the court overruled its precedents on the ground that their case-by-case approach had proved unworkable.

****1833 Held:** Prosecution history estoppel may apply to any claim amendment made to satisfy the Patent Act's requirements, not just to amendments made to avoid the prior art, but estoppel need not bar suit against every equivalent to the amended claim element. Pp. 1837-1843.

***723 a)** To enable a patent holder to know what he owns, and the public to know what he does not, the inventor must describe his work in "full, clear, concise, and exact terms." § 112. However, patent claim language may not describe with complete precision the range of an invention's novelty. If patents were always interpreted by their literal terms, their value would be greatly diminished. Insubstantial substitutes for certain elements could defeat the patent, and its value to inventors could be destroyed by simple acts of copying. Thus, a patent's scope is not limited to its literal terms, but embraces all equivalents to the claims described. See *Winans v. Denmead*, 56 U.S. (15 How.) 330, 347, 14 L.Ed. 717. Nevertheless, because it may be difficult to determine what is, or is not, an equivalent, competitors may be deterred from engaging in legitimate manufactures outside the patent's limits, or lulled into developing competing products that the patent secures, thereby prompting wasteful litigation. Each time the Court has considered the doctrine of equivalents, it has acknowledged this uncertainty as the price of ensuring the appropriate incentives for innovation, and it has affirmed the doctrine over dissents that urged a more certain rule. See, e.g., *id.*, at 343, 347. Most recently, *Warner-Jenkinson*, *supra*, at 28, 117 S.Ct. 1040, reaffirmed the doctrine. Pp. 1837-1838.

(b) Prosecution history estoppel requires that patent claims be interpreted in light of the proceedings before the Patent and Trademark Office (PTO). When the patentee originally claimed the subject matter alleged to infringe but then narrowed the claim in response to a rejection, he may not argue that the surrendered territory comprised an unforeseen equivalent. See *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U.S. 126, 136-137, 62 S.Ct. 513, 86 L.Ed. 736. The rejection indicates that the patent examiner does not believe the original claim could be patented. While the patentee has the right to appeal, his decision to forgo an appeal and submit an amended claim is taken as a concession that the invention as patented does not reach as far as the original claim. See, e.g., *Goodyear Dental Vulcanite Co. v. Davis*, 102 U.S. 222, 228, 26 L.Ed. 149. Were it otherwise, the inventor might avoid the PTO's gatekeeping role and seek to recapture in an infringement action the very subject matter surrendered as a condition of receiving the patent. Pp. 1838- 1839.

(c) Prosecution history estoppel is not limited to amendments intended to narrow the patented invention's subject matter, e.g., to avoid prior art, but may apply to a narrowing amendment made to satisfy any Patent Act requirement, including § 112's requirements concerning the patent application's form. In *Warner-Jenkinson*, the Court made clear that estoppel applies to amendments made for a "substantial reason related to patentability," 520 U.S., at 33, 117 S.Ct. 1040, but did not purport to catalog every reason that might raise an estoppel. Indeed, it stated that even ***724** if the amendment's purpose were unrelated to patentability, the court might consider whether it was the kind of reason that nonetheless might require estoppel. *Id.*, at 40-41, 117 S.Ct. 1040. Simply because estoppel has been discussed most often in the context of amendments made to avoid the prior art, see, e.g., *id.*, at 30, 117 S.Ct. 1040, it does not follow that amendments made for other purposes will not give rise to estoppel. Section 112 requires that the application describe, enable, and set forth the best mode of carrying out the invention. The patent should not issue if these requirements are not satisfied, and an applicant's failure to meet them could lead to the issued patent being held invalid in later litigation. Festo's argument that ****1834** amendments made to comply with § 112 concern the application's form and not the invention's subject matter conflates the patentee's reason for making the amendment with the impact the amendment has on the subject matter. Estoppel arises when an amendment is made to secure the patent and the amendment narrows the patent's scope. If a § 112 amendment is truly cosmetic, it would not narrow the patent's scope or raise an estoppel. But if a § 112 amendment is necessary and narrows the patent's scope—even if only for better description—estoppel may apply. Pp. 1839-1840.

(d) Prosecution history estoppel does not bar the inventor from asserting infringement against every equivalent to the narrowed element. Though estoppel can bar challenges to a wide range of equivalents, its reach requires an examination of the subject matter surrendered by the narrowing amendment. The Federal Circuit's complete bar rule

is inconsistent with the purpose of applying the estoppel in the first place--to hold the inventor to the representations made during the application process and the inferences that may be reasonably drawn from the amendment. By amending the application, the inventor is deemed to concede that the patent does not extend as far as the original claim, not that the amended claim is so perfect in its description that no one could devise an equivalent. The Court's view is consistent with precedent and PTO practice. The Court has consistently applied the doctrine in a flexible way, considering what equivalents were surrendered during a patent's prosecution, rather than imposing a complete bar that resorts to the very literalism the equivalents rule is designed to overcome. *E.g., Goodyear Dental, supra*, at 230, 12 Otto 222, 26 L.Ed. 149. The Federal Circuit ignored *Warner-Jenkinson's* instruction that courts must be cautious before adopting changes that disrupt the settled expectations of the inventing community. See 520 U.S., at 28, 117 S.Ct. 1040. Inventors who amended their claims under the previous case law had no reason to believe they were conceding all equivalents. Had they known, they might have appealed the rejection instead. *Warner-Jenkinson* struck the appropriate balance by placing the burden on the patentee to prove that an ***725** amendment was not made for a reason that would give rise to estoppel. *Id.*, at 33, 117 S.Ct. 1040. Similarly, the patentee should bear the burden of showing that the amendment does not surrender the particular equivalent in question. As the author of the claim language, his decision to narrow his claims through amendment may be presumed to be a general disclaimer of the territory between the original claim and the amended claim. *Exhibit Supply, supra*, at 136-137, 62 S.Ct. 513. However, in cases in which the amendment cannot reasonably be viewed as surrendering a particular equivalent--*e.g.*, where the equivalent was unforeseeable at the time of the application or the rationale underlying the amendment bears but a tangential relation to the equivalent--the patentee can rebut the presumption that prosecution history estoppel bars a finding of equivalence by showing that at the time of the amendment one skilled in the art could not reasonably be expected to have drafted a claim that would have literally encompassed the alleged equivalent. Pp. 1840-1842.

(e) Whether Festo has rebutted the presumptions that estoppel applies and that the equivalents at issue have been surrendered should be determined in the first instance by further proceedings below. Pp. 1842-1843. 234 F.3d 558, vacated and remanded.

KENNEDY, J., delivered the opinion for a unanimous Court.

Robert H. Bork, Washington, DC, for the petitioner.

Lawrence G. Wallace, Washington, DC, for the United States as amicus curiae, by special leave of the Court, supporting vacatur and remand.

****1835** Arthur I. Neustadt, Arlington, VA, for the respondents.

***726** Justice KENNEDY delivered the opinion of the Court.

This case requires us to address once again the relation between two patent law concepts, the doctrine of equivalents and the rule of prosecution history estoppel. The Court considered the same concepts in *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 117 S.Ct. 1040, 137 L.Ed.2d 146 (1997), and reaffirmed ***727** that a patent protects its holder against efforts of copyists to evade liability for infringement by making only insubstantial changes to a patented invention. At the same time, we appreciated that by extending protection beyond the literal terms in a patent the doctrine of equivalents can create substantial uncertainty about where the patent monopoly ends. *Id.*, at 29, 117 S.Ct. 1040. If the range of equivalents is unclear, competitors may be unable to determine what is a permitted alternative to a patented invention and what is an infringing equivalent.

To reduce the uncertainty, *Warner-Jenkinson* acknowledged that competitors may rely on the prosecution history, the public record of the patent proceedings. In some cases the Patent and Trademark Office (PTO) may have rejected an earlier version of the patent application on the ground that a claim does not meet a statutory requirement for patentability. 35 U.S.C. § 132 (1994 ed., Supp. V). When the patentee responds to the rejection by narrowing his claims, this prosecution history estops him from later arguing that the subject matter covered by the original, broader claim was nothing more than an equivalent. Competitors may rely on the estoppel to ensure that their own devices will not be found to infringe by equivalence.

In the decision now under review the Court of Appeals for the Federal Circuit held that by narrowing a claim to obtain a patent, the patentee surrenders all equivalents to the amended claim element. Petitioner asserts this holding departs from past precedent in two respects. First, it applies estoppel to every amendment made to satisfy the requirements of the Patent Act and not just to amendments made to avoid pre-emption by an earlier invention, *i.e.*, the prior art. Second, it holds that when estoppel arises, it bars suit against every equivalent to the amended claim element. The Court of Appeals acknowledged that this holding departed from its own cases, which applied a flexible bar when considering what claims of equivalence were estopped by the ***728** prosecution history. Petitioner argues that by replacing the flexible bar with a complete bar the Court of Appeals cast doubt on many existing patents that were amended during the application process when the law, as it then stood, did not apply so rigorous a standard. We granted certiorari to consider these questions.

Petitioner Festo Corporation owns two patents for an improved magnetic rodless cylinder, a piston-driven device that relies on magnets to move objects in a conveying system. The device has many industrial uses and has been employed in machinery as diverse as sewing equipment and the Thunder Mountain ride at Disney World. Although the precise details of the cylinder's operation are not essential here, the prosecution history must be considered.

Petitioner's patent applications, as often occurs, were amended during the prosecution proceedings. The application for the first patent, the Stoll Patent (U.S. Patent No. 4,354,125), was amended after the patent examiner rejected the initial application because the exact method of operation was unclear and some claims were made in ****1836** an impermissible way. (They were multiply dependent.) 35 U.S.C. § 112 (1994 ed.). The inventor, Dr. Stoll, submitted a new application designed to meet the examiner's objections and also added certain references to prior art. 37 CFR § 1.56 (2000). The second patent, the Carroll Patent (U.S. Patent No. 3,779,401), was also amended during a reexamination proceeding. The prior art references were added to this amended application as well. Both amended patents added a new limitation—that the inventions contain a pair of sealing rings, each having a lip on one side, which would prevent impurities from getting on the piston assembly. The amended Stoll Patent added the further limitation that the outer shell of the device, the sleeve, be made of a magnetizable material.

***729** After Festo began selling its rodless cylinder, respondents (whom we refer to as SMC) entered the market with a device similar, but not identical, to the ones disclosed by Festo's patents. SMC's cylinder, rather than using two one-way sealing rings, employs a single sealing ring with a two-way lip. Furthermore, SMC's sleeve is made of a nonmagnetizable alloy. SMC's device does not fall within the literal claims of either patent, but petitioner contends that it is so similar that it infringes under the doctrine of equivalents.

SMC contends that Festo is estopped from making this argument because of the prosecution history of its patents. The sealing rings and the magnetized alloy in the Festo product were both disclosed for the first time in the amended applications. In SMC's view, these amendments narrowed the earlier applications, surrendering alternatives that are the very points of difference in the competing devices—the sealing rings and the type of alloy used to make the sleeve. As Festo narrowed its claims in these ways in order to obtain the patents, says SMC, Festo is now estopped from saying that these features are immaterial and that SMC's device is an equivalent of its own.

The United States District Court for the District of Massachusetts disagreed. It held that Festo's amendments were not made to avoid prior art, and therefore the amendments were not the kind that give rise to estoppel. A panel of the Court of Appeals for the Federal Circuit affirmed. 72 F.3d 857 (1995). We granted certiorari, vacated, and remanded in light of our intervening decision in *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 117 S.Ct. 1040, 137 L.Ed.2d 146 (1997). After a decision by the original panel on remand, 172 F.3d 1361 (1999), the Court of Appeals ordered rehearing en banc to address questions that had divided its judges since our decision in *Warner-Jenkinson*. 187 F.3d 1381 (1999).

The en banc court reversed, holding that prosecution history estoppel barred Festo from asserting that the accused device infringed its patents under the doctrine of equivalents. ***730** 234 F.3d 558 (2000). The court held, with only one judge dissenting, that estoppel arises from any amendment that narrows a claim to comply with the Patent Act, not only from amendments made to avoid prior art. *Id.*, at 566. More controversial in the Court of Appeals was its further holding: When estoppel applies, it stands as a complete bar against any claim of equivalence for the element that was amended. *Id.*, at 574-575. The court acknowledged that its own prior case law did not go so far. Previous decisions had held that prosecution history estoppel constituted a flexible bar, foreclosing some, but not all, claims of equivalence, depending on the purpose of the amendment and the alterations in the text. The court concluded, however, that its precedents applying the flexible-bar rule should be overruled because this case-by-case approach has proved unworkable. In the court's view a complete-bar rule, under which estoppel bars all claims of equivalence to the narrowed element, would promote certainty in the determination of infringement cases.

****1837** Four judges dissented from the decision to adopt a complete bar. *Id.*, at 562. In four separate opinions, the dissenters argued that the majority's decision to overrule precedent was contrary to *Warner-Jenkinson* and would unsettle the expectations of many existing patentees. Judge Michel, in his dissent, described in detail how the complete bar required the Court of Appeals to disregard 8 older decisions of this Court, as well as more than 50 of its own cases. 234 F.3d, at 601-616.

We granted certiorari. 533 U.S. 915, 121 S.Ct. 2519, 150 L.Ed.2d 692 (2001).

II

[1] The patent laws "promote the Progress of Science and useful Arts" by rewarding innovation with a temporary monopoly. U.S. Const., Art. I, § 8, cl. 8. The monopoly is a property right; and like any property right, its boundaries should be clear. This clarity is essential to promote progress, because ***731** it enables efficient investment in innovation. A patent holder should know what he owns, and the public should know what he does not. For this reason, the patent laws require inventors to describe their work in "full, clear, concise, and exact terms," 35 U.S.C. § 112, as part of the delicate balance the law attempts to maintain between inventors, who rely on the promise of the law to bring the invention forth, and the public, which should be encouraged to pursue innovations, creations, and new ideas beyond the inventor's exclusive rights. *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 150, 109 S.Ct. 971, 103 L.Ed.2d 118 (1989).

[2] Unfortunately, the nature of language makes it impossible to capture the essence of a thing in a patent application. The inventor who chooses to patent an invention and disclose it to the public, rather than exploit it in secret, bears the risk that others will devote their efforts toward exploiting the limits of the patent's language: "An invention exists most importantly as a tangible structure or a series of drawings. A verbal portrayal is usually an afterthought written to satisfy the requirements of patent law. This conversion of machine to words allows for unintended idea gaps which cannot be satisfactorily filled. Often the invention is novel and words do not exist to describe it. The dictionary does not always keep abreast of the inventor. It cannot. Things are not made for the sake of words, but words for things." *Autogiro Co. of America v. United States*, 181 Ct.Cl. 55, 384 F.2d 391, 397 (1967).

The language in the patent claims may not capture every nuance of the invention or describe with complete precision the range of its novelty. If patents were always interpreted by their literal terms, their value would be greatly diminished. Unimportant and insubstantial substitutes for certain elements could defeat the patent, and its value to inventors could be destroyed by simple acts of copying. For this ***732** reason, the clearest rule of patent interpretation, literalism, may conserve judicial resources but is not necessarily the most efficient rule. The scope of a patent is not limited to its literal terms but instead embraces all equivalents to the claims described. See *Winans v. Denmead*, 56 U.S. (15 How.) 330, 347, 14 L.Ed. 717 (1854).

It is true that the doctrine of equivalents renders the scope of patents less certain. It may be difficult to determine what is, or is not, an equivalent to a particular element of an invention. If competitors cannot be certain about a patent's extent, they may be deterred from engaging in legitimate manufactures outside its limits, or they may invest by mistake in competing products that the patent secures. In addition the uncertainty may lead to wasteful litigation between competitors, suits that a rule of literalism might avoid. These concerns with the doctrine of equivalents, however, are not new. Each time the ****1838** Court has considered the doctrine, it has acknowledged this uncertainty as the price of ensuring the appropriate incentives for innovation, and it has affirmed the doctrine over dissents that urged a more certain rule. When the Court in *Winans v. Denmead*, *supra*, first adopted what has become the doctrine of equivalents, it stated that "[t]he exclusive right to the thing patented is not secured, if the public are at liberty to make substantial copies of it, varying its form or proportions." *Id.*, at 343. The dissent argued that the Court had sacrificed the objective of "[f]ul[l]ness, clearness, exactness, preciseness, and particularity, in the description of the invention." *Id.*, at 347 (opinion of Campbell, J.).

The debate continued in *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 339 U.S. 605, 70 S.Ct. 854, 94 L.Ed. 1097 (1950), where the Court reaffirmed the doctrine. *Graver Tank* held that patent claims must protect the inventor not only from those who produce devices falling within the literal claims of the patent but also from copyists who "make unimportant and insubstantial changes and substitutions in the patent which, though adding ***733** nothing, would be enough to take the copied matter outside the claim, and hence outside the reach of law." *Id.*, at 607, 70 S.Ct. 854. Justice Black, in dissent, objected that under the doctrine of equivalents a competitor "cannot rely on what the language of a patent claims. He must be able, at the peril of heavy infringement damages, to forecast how far a court relatively unversed in a particular technological field will expand the claim's language" *Id.*, at 617, 70 S.Ct. 854.

Most recently, in *Warner-Jenkinson*, the Court reaffirmed that equivalents remain a firmly entrenched part of the settled rights protected by the patent. A unanimous opinion concluded that if the doctrine is to be discarded, it is Congress and not the Court that should do so:

"[T]he lengthy history of the doctrine of equivalents strongly supports adherence to our refusal in *Graver Tank* to find that the Patent Act conflicts with that doctrine. Congress can legislate the doctrine of equivalents out of existence any time it chooses. The various policy arguments now made by both sides are thus best addressed to Congress, not this Court." 520 U.S., at 28, 117 S.Ct. 1040.

III

[3][4] Prosecution history estoppel requires that the claims of a patent be interpreted in light of the proceedings in the PTO during the application process. Estoppel is a "rule of patent construction" that ensures that claims are interpreted by reference to those "that have been cancelled or rejected." *Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U.S. 211, 220-221, 61 S.Ct. 235, 85 L.Ed. 132 (1940). The doctrine of equivalents allows the patentee to claim those insubstantial alterations that were not captured in drafting the original patent claim but which could be created through trivial changes. When, however, the patentee originally claimed the subject matter alleged to infringe but then narrowed the claim in response to a rejection, he may not argue that the surrendered territory comprised ***734** unforeseen subject matter that should be deemed equivalent to the literal claims of the issued patent. On the contrary, "[b]y the amendment [the patentee] recognized and emphasized the difference between the two phrases [,] ... and [t]he difference which [the patentee] thus disclaimed must be regarded as material." *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U.S. 126, 136-137, 62 S.Ct. 513, 86 L.Ed. 736 (1942).

A rejection indicates that the patent examiner does not believe the original claim could be patented. While the patentee has the right to appeal, his decision to forgo an appeal and submit an amended claim is taken as a concession that the invention as patented does not reach as far as the original claim. See ****1839** *Goodyear Dental Vulcanite Co. v. Davis*, 102 U.S. 222, 228, 26 L.Ed. 149 (1880) ("In view of [the amendment] there can be no doubt of what [the patentee] understood he had patented, and that both he and the commissioner regarded the patent to be for a manufacture made exclusively of vulcanites by the detailed process"); *Wang Laboratories, Inc. v. Mitsubishi Electronics America, Inc.*, 103 F.3d 1571, 1577-1578 (C.A.Fed.1997) ("Prosecution history estoppel ... preclud[es] a patentee from regaining, through litigation, coverage of subject matter relinquished during prosecution of the application for the patent"). Were it otherwise, the inventor might avoid the PTO's gatekeeping role and seek to recapture in an infringement action the very subject matter surrendered as a condition of receiving the patent. Prosecution history estoppel ensures that the doctrine of equivalents remains tied to its underlying purpose. Where the original application once embraced the purported equivalent but the patentee narrowed his claims to obtain the patent or to protect its validity, the patentee cannot assert that he lacked the words to describe the subject matter in question. The doctrine of equivalents is premised on language's inability to capture the essence of innovation, but a prior application describing the precise element at issue undercuts that premise. In that instance the prosecution history has ***735** established that the inventor turned his attention to the subject matter in question, knew the words

for both the broader and narrower claim, and affirmatively chose the latter.

A

The first question in this case concerns the kinds of amendments that may give rise to estoppel. Petitioner argues that estoppel should arise when amendments are intended to narrow the subject matter of the patented invention, for instance, amendments to avoid prior art, but not when the amendments are made to comply with requirements concerning the form of the patent application. In *Warner-Jenkinson* we recognized that prosecution history estoppel does not arise in every instance when a patent application is amended. Our "prior cases have consistently applied prosecution history estoppel only where claims have been amended for a limited set of reasons," such as "to avoid the prior art, or otherwise to address a specific concern--such as obviousness--that arguably would have rendered the claimed subject matter unpatentable." 520 U.S., at 30-32, 117 S.Ct. 1040. While we made clear that estoppel applies to amendments made for a "substantial reason related to patentability," *id.*, at 33, 117 S.Ct. 1040, we did not purport to define that term or to catalog every reason that might raise an estoppel. Indeed, we stated that even if the amendment's purpose were unrelated to patentability, the court might consider whether it was the kind of reason that nonetheless might require resort to the estoppel doctrine. *Id.*, at 40-41, 117 S.Ct. 1040.

Petitioner is correct that estoppel has been discussed most often in the context of amendments made to avoid the prior art. See *Exhibit Supply Co.*, *supra*, at 137, 62 S.Ct. 513; *Keystone Driller Co. v. Northwest Engineering Corp.*, 294 U.S. 42, 48, 55 S.Ct. 262, 79 L.Ed. 747 (1935). Amendment to accommodate prior art was the emphasis, too, of our decision in *Warner-Jenkinson*, *supra*, at 30, 117 S.Ct. 1040. It does not follow, however, that amendments for other purposes will not give rise to estoppel. Prosecution *736 history may rebut the inference that a thing not described was indescribable. That rationale does not cease simply because the narrowing amendment, submitted to secure a patent, was for some purpose other than avoiding prior art.

[5] We agree with the Court of Appeals that a narrowing amendment made to satisfy any requirement of the Patent Act may give rise to an estoppel. As that court explained, a number of statutory requirements must be satisfied before a patent **1840 can issue. The claimed subject matter must be useful, novel, and not obvious. 35 U.S.C. §§ 101-103 (1994 ed. and Supp. V). In addition, the patent application must describe, enable, and set forth the best mode of carrying out the invention. § 112 (1994 ed.). These latter requirements must be satisfied before issuance of the patent, for exclusive patent rights are given in exchange for disclosing the invention to the public. See *Bonito Boats*, 489 U.S., at 150-151, 109 S.Ct. 971. What is claimed by the patent application must be the same as what is disclosed in the specification; otherwise the patent should not issue. The patent also should not issue if the other requirements of § 112 are not satisfied, and an applicant's failure to meet these requirements could lead to the issued patent being held invalid in later litigation.

Petitioner contends that amendments made to comply with § 112 concern the form of the application and not the subject matter of the invention. The PTO might require the applicant to clarify an ambiguous term, to improve the translation of a foreign word, or to rewrite a dependent claim as an independent one. In these cases, petitioner argues, the applicant has no intention of surrendering subject matter and should not be estopped from challenging equivalent devices. While this may be true in some cases, petitioner's argument conflates the patentee's reason for making the amendment with the impact the amendment has on the subject matter.

Estoppel arises when an amendment is made to secure the patent and the amendment narrows the patent's scope. If a § 112 amendment is truly cosmetic, then it would not narrow *737 the patent's scope or raise an estoppel. On the other hand, if a § 112 amendment is necessary and narrows the patent's scope--even if only for the purpose of better description--estoppel may apply. A patentee who narrows a claim as a condition for obtaining a patent disavows his claim to the broader subject matter, whether the amendment was made to avoid the prior art or to comply with § 112. We must regard the patentee as having conceded an inability to claim the broader subject matter or at least as having abandoned his right to appeal a rejection. In either case estoppel may apply.

B

[6] Petitioner concedes that the limitations at issue--the sealing rings and the composition of the sleeve--were made for reasons related to § 112, if not also to avoid the prior art. Our conclusion that prosecution history estoppel arises when a claim is narrowed to comply with § 112 gives rise to the second question presented: Does the estoppel bar the inventor from asserting infringement against any equivalent to the narrowed element or might some equivalents still infringe? The Court of Appeals held that prosecution history estoppel is a complete bar, and so the narrowed element must be limited to its strict literal terms. Based upon its experience the Court of Appeals decided that the flexible-bar rule is unworkable because it leads to excessive uncertainty and burdens legitimate innovation. For the reasons that follow, we disagree with the decision to adopt the complete bar.

[7][8] Though prosecution history estoppel can bar a patentee from challenging a wide range of alleged equivalents made or distributed by competitors, its reach requires an examination of the subject matter surrendered by the narrowing amendment. The complete bar avoids this inquiry by establishing a *per se* rule; but that approach is inconsistent with the purpose of applying the estoppel in the first place--to hold the inventor to the representations made during the application process and to the inferences that may reasonably *738 be drawn from the amendment. By amending the application, the inventor is deemed to concede that the patent does not extend as far as the original claim. It does not follow, however, **1841 that the amended claim becomes so perfect in its description that no one could devise an equivalent. After amendment, as before, language remains an imperfect fit for invention. The narrowing amendment may demonstrate what the claim is not; but it may still fail to capture precisely what the claim is. There is no reason why a narrowing amendment should be deemed to relinquish equivalents unforeseeable at the

time of the amendment and beyond a fair interpretation of what was surrendered. Nor is there any call to foreclose claims of equivalence for aspects of the invention that have only a peripheral relation to the reason the amendment was submitted. The amendment does not show that the inventor suddenly had more foresight in the drafting of claims than an inventor whose application was granted without amendments having been submitted. It shows only that he was familiar with the broader text and with the difference between the two. As a result, there is no more reason for holding the patentee to the literal terms of an amended claim than there is for abolishing the doctrine of equivalents altogether and holding every patentee to the literal terms of the patent.

This view of prosecution history estoppel is consistent with our precedents and respectful of the real practice before the PTO. While this Court has not weighed the merits of the complete bar against the flexible bar in its prior cases, we have consistently applied the doctrine in a flexible way, not a rigid one. We have considered what equivalents were surrendered during the prosecution of the patent, rather than imposing a complete bar that resorts to the very literalism the equivalents rule is designed to overcome. *E.g.*, *Goodyear Dental Vulcanite Co.*, 102 U.S., at 230, 26 L.Ed. 149; *Hurlbut v. Schillinger*, 130 U.S. 456, 465, 9 S.Ct. 584, 32 L.Ed. 1011 (1889).

*739 The Court of Appeals ignored the guidance of *Warner-Jenkinson*, which instructed that courts must be cautious before adopting changes that disrupt the settled expectations of the inventing community. See 520 U.S., at 28, 117 S.Ct. 1040. In that case we made it clear that the doctrine of equivalents and the rule of prosecution history estoppel are settled law. The responsibility for changing them rests with Congress. *Ibid.* Fundamental alterations in these rules risk destroying the legitimate expectations of inventors in their property. The petitioner in *Warner-Jenkinson* requested another bright-line rule that would have provided more certainty in determining when estoppel applies but at the cost of disrupting the expectations of countless existing patent holders. We rejected that approach: "To change so substantially the rules of the game now could very well subvert the various balances the PTO sought to strike when issuing the numerous patents which have not yet expired and which would be affected by our decision." *Id.*, at 32, n. 6, 117 S.Ct. 1040; see also *id.*, at 41, 117 S.Ct. 1040 (GINSBURG, J., concurring) ("The new presumption, if applied woodenly, might in some instances unfairly discount the expectations of a patentee who had no notice at the time of patent prosecution that such a presumption would apply"). As *Warner-Jenkinson* recognized, patent prosecution occurs in the light of our case law. Inventors who amended their claims under the previous regime had no reason to believe they were conceding all equivalents. If they had known, they might have appealed the rejection instead. There is no justification for applying a new and more robust estoppel to those who relied on prior doctrine.

In *Warner-Jenkinson* we struck the appropriate balance by placing the burden on the patentee to show that an amendment was not for purposes of patentability:

"Where no explanation is established, however, the court should presume that the patent application had a substantial reason related to patentability for including the limiting element added by amendment. In those *740 circumstances, prosecution history estoppel would bar the application of the doctrine of equivalents **1842 as to that element." *Id.*, at 33, 117 S.Ct. 1040.

When the patentee is unable to explain the reason for amendment, estoppel not only applies but also "bar[s] the application of the doctrine of equivalents as to that element." *Ibid.* These words do not mandate a complete bar; they are limited to the circumstance where "no explanation is established." They do provide, however, that when the court is unable to determine the purpose underlying a narrowing amendment--and hence a rationale for limiting the estoppel to the surrender of particular equivalents--the court should presume that the patentee surrendered all subject matter between the broader and the narrower language.

[9][10][11] Just as *Warner-Jenkinson* held that the patentee bears the burden of proving that an amendment was not made for a reason that would give rise to estoppel, we hold here that the patentee should bear the burden of showing that the amendment does not surrender the particular equivalent in question. This is the approach advocated by the United States, see Brief for United States as *Amicus Curiae* 22-28, and we regard it to be sound. The patentee, as the author of the claim language, may be expected to draft claims encompassing readily known equivalents. A patentee's decision to narrow his claims through amendment may be presumed to be a general disclaimer of the territory between the original claim and the amended claim. *Exhibit Supply*, 315 U.S., at 136-137, 62 S.Ct. 513 ("By the amendment [the patentee] recognized and emphasized the difference between the two phrases and proclaimed his abandonment of all that is embraced in that difference"). There are some cases, however, where the amendment cannot reasonably be viewed as surrendering a particular equivalent. The equivalent may have been unforeseeable at the time of the application; the rationale underlying the amendment may bear no more than a tangential relation to the equivalent in question; or there *741 may be some other reason suggesting that the patentee could not reasonably be expected to have described the insubstantial substitute in question. In those cases the patentee can overcome the presumption that prosecution history estoppel bars a finding of equivalence.

This presumption is not, then, just the complete bar by another name. Rather, it reflects the fact that the interpretation of the patent must begin with its literal claims, and the prosecution history is relevant to construing those claims. When the patentee has chosen to narrow a claim, courts may presume the amended text was composed with awareness of this rule and that the territory surrendered is not an equivalent of the territory claimed. In those instances, however, the patentee still might rebut the presumption that estoppel bars a claim of equivalence. The patentee must show that at the time of the amendment one skilled in the art could not reasonably be expected to have drafted a claim that would have literally encompassed the alleged equivalent.

IV

On the record before us, we cannot say petitioner has rebutted the presumptions that estoppel applies and that the equivalents at issue have been surrendered. Petitioner concedes that the limitations at issue--the sealing rings and the composition of the sleeve--were made in response to a rejection for reasons under § 112, if not also because of the prior art references. As the amendments were made for a reason relating to patentability, the question is not whether estoppel applies but what territory the amendments surrendered. While estoppel does not effect a complete bar, the question remains whether petitioner can demonstrate that the narrowing amendments did not surrender the particular equivalents at issue. On these questions, SMC may well prevail, for the sealing rings and the composition of the sleeve both were noted expressly in the prosecution history. These matters, ****1843** however, should be determined in the first instance ***742** by further proceedings in the Court of Appeals or the District Court. The judgment of the Federal Circuit is vacated, and the case is remanded for further proceedings consistent with this opinion.

It is so ordered.











U.S., 2002.


Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.


535 U.S. 722, 122 S.Ct. 1831, 152 L.Ed.2d 944, 70 USLW 4458, 62 U.S.P.Q.2d 1705, 02 Cal. Daily Op. Serv. 4539, 2002 Daily Journal D.A.R. 5803, 15 Fla. L. Weekly Fed. S 320

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
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EXHIBIT 12

7 PAGES

Translated from the German

FEDERAL REPUBLIC OF GERMANY
GERMAN PATENT OFFICE

OFFENLEGUNGSSCHRIFT

DE 33 16 818

IPC: B 60 R 11/02

B 60 J 3/00

→ Date of application: May 7, 1983
Date the 'offenlegungsschrift' was laid open to public inspection: November 8, 1984
Applicant: Hans-Hellmut Ernst [residing in Sülfeld, DE]
Inventor: the same as the applicant
[Title in German of the object of the invention:]
Sonnenblende mit audiovisuellen Einrichtungen

SUN-VISOR*, HAVING AUDIOVISUAL DEVICES

Sun-visor* [*Translator's note: Also known as sunshield (to eliminate stray light), sun screen; sun shade; rayshade]

(54) The invention pertains to a sun visor in motor vehicles, which provides an expanded utilization possibility for the occupants. In order for the desired comfort, entertainment and information access of the motorists to be improved, a display screen (2), a loudspeaker (3), a control and input keyboard (4)



DEUTSCHES
PATENTAMT

⑳ Aktenzeichen: P 33 16 818.0
㉑ Anmeldetag: 7. 5. 83
㉒ Offenlegungstag: 8. 11. 84

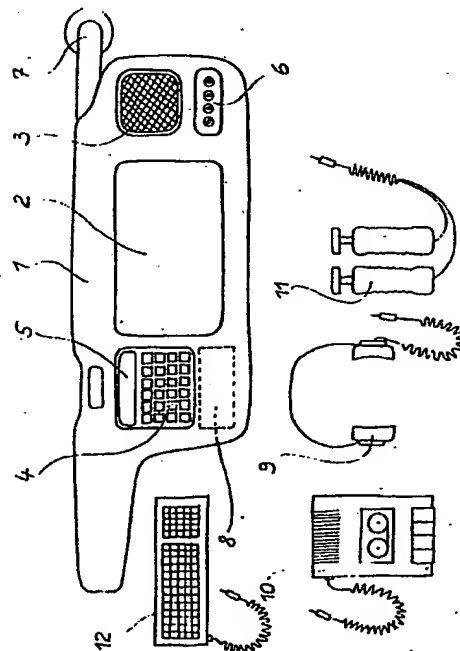
DE 3316818 A1

㉓ Anmelder:
Ernst, Hans-Hellmut, Dipl.-Ing., 2061 Sülfeld, DE

㉔ Erfinder:
gleich Anmelder

⑤ Sonnenblende mit audiovisuellen Einrichtungen

Die Erfindung betrifft eine Sonnenblende in Kraftfahrzeugen, die eine erweiterte Nutzungsmöglichkeit für die Insassen bietet. Zur Steigerung der Komfort-, Unterhaltungs- und Informationswünsche der Autofahrer sind auf der Rückseite ein Bildschirm (2), ein Lautsprecher (3), eine Bedienungs- und Eingabetastatur (4) und Anschlußbuchsen (6) in Verbindung mit einem Computersystem (8) integriert. Mit diesen Bauteilen lassen sich TV-Programme empfangen, Videospiele durchführen, visuelle Verkehrsinfos einblenden, Bild-Telefon-Gespräche führen, EDV-Programme bearbeiten und sonstige Möglichkeiten der audiovisuellen Unterhaltungs- und Informationselektronik nutzen.



DE 3316818 A1

Patentansprüche

1. Sonnenblende als Blendschutz in Kraftfahrzeugen, die von einer oberen Stellung in eine untere Stellung bewegbar ist, dadurch gekennzeichnet, daß auf der Rückseite der Sonnenblende (1), die im heruntergeklappten Zustand für den Insassen sichtbar wird, ein Bildschirm (2) als Display und Monitor, ein Lautsprecher (3), eine Bedienungs- und Eingabetastatur (4), mehrere Anschlußbuchsen (6) und ein Rechner/Computer/Video-System (8) angebracht sind.
2. Sonnenblende nach Anspruch 1, dadurch gekennzeichnet, daß eine Sonnenblende (1') nur mit einem oder einigen der angegebenen Bauteile (2,3,4,6,8) ausgerüstet ist.

Sonnenblende mit audiovisuellen Einrichtungen

Sonnenblenden dienen in Kraftfahrzeugen vorzugsweise für die vorderen Insassen als Blendschutzeinrichtung. Im Falle des starken Lichteinfalls von vorne werden sie von einer oberen Stellung in eine untere Gebrauchsstellung geklappt.

Es sind schon Sonnenblenden bekannt geworden, die für erweiterbare Aufgabenstellungen mit weiteren Bauteilen bestückt wurden. So, z. B. mit Spiegeln, Leuchten, Parkscheiben oder Brillenhalterungen.

Der Erfindung liegt die Aufgabe zugrunde, die Nutzungsmöglichkeit der Sonnenblende, insbesondere auf der Beifahrerseite, dahingehend zu steigern, daß dem Komfort-, Unterhaltungs- und Informationswunsch der Autofahrer besser entsprochen werden kann.

Diese Aufgabe wird erfindungsgemäß dadurch gelöst, daß in die Sonnenblende auf der Rückseite, die dem Insassen in der heruntergeklappten Stellung zugewandt ist, audiovisuelle Bauteile neuester Technologie (Flachbauweise) und Computerbauteile integriert werden.

Dies können beispielsweise Lautsprecher sein, die in den Sonnenblenden von Fahrer und Beifahrer placent für einen besonders guten Raumklang und Stereoeffekt sorgen.

Da zukünftig TV-Bildschirme in extremer Flachbauweise und mit geringem Gewicht zur Verfügung stehen werden, lassen sich auch Displays bzw. Monitore für die verschiedensten Zwecke in eine Sonnenblende integrieren.

Desweiteren lassen sich Rechner oder in erweiterter Form kleine Computer-Systeme integrieren. Eine Eingabe- und Bedienungstastatur ist mit allen Bauteilen verbunden und ermöglicht die gewünschte Programmsteuerung.

So lassen sich TV-Programme empfangen, Video-Spiele durchführen, Rechenprogramme aufstellen und auf dem Bildschirm darstellen, Verkehrsinformationen visuell abrufen oder sonstige Wünsche der Unterhaltungselektronik, EDV und Informatik audiovisuell ermöglichen.

Über Anschlußbuchsen 6 lassen sich Kopfhörer 9, Spielpilot-Hebel 11 oder externe Geräte (Autoradio, Bordcomputer, Kassettenabspielgerät 10 für Videospiele oder gespeicherte Programme, Bildtelefon u. ä.) anschließen.

Auf diese Weise ergibt sich sowohl für den privat als auch für den geschäftlich reisenden Mitfahrer die Möglichkeit, die Reisezeit den eigenen Wünschen entsprechend besser zu nutzen.

In der Fig. 1 ist eine Ausführungsform der erfindungsgemäßen Sonnenblende dargestellt. Der Blick ist auf die Rückseite der heruntergeklappten Sonnenblende 1 gerichtet. Den größten Platz in der Mitte nimmt der Bildschirm 2 ein. Er kann wahlweise als Display für den Rechner/Computer 8 oder als Monitor für TV, Videospiele, Verkehrsinformationen oder Bildtelefon genutzt werden. Entsprechend vielseitig ist der Gebrauch des Lautsprechers 3. Die Bedienungs- und Eingabetastatur 4 ist für die Steuerung und Regelung der audiovisuellen Bauteile (2,3,6) und des Rechners/Computers 8 ausgelegt. Über die Anschlußbuchsen 6 lassen sich weitere Aggregate mit dem System verbinden. Eine externe Eingabetastatur 12, ein Kassettenabspielgerät 10 für das Laden und Speichern von Programmen oder Videospiele, ein Kopfhörer 9 oder Spielpilot-Hebel 11.

Bezeichnungen

- | | |
|----|---------------------------------|
| 1 | Sonnenblende |
| 2 | Bildschirm |
| 3 | Lautsprecher |
| 4 | Bedienungs- und Eingabetastatur |
| 5 | Zeilen-Display |
| 6 | Anschlußbuchsen |
| 7 | Halterung |
| 8 | Rechner/Computer/Videospiel |
| 9 | Kopfhörer |
| 10 | Kassettenabspielgerät |
| 11 | Spielpilot-Hebel |
| 12 | Externe Eingabetastatur |

-4-

- Leerseite -

3316818

-5-
-6-

Nummer: 33 16 818
 Int. Cl.³: B 60 R 11/02
 Anmeldetag: 7. Mai 1983
 Offenlegungstag: 8. November 1984

Fig. 1

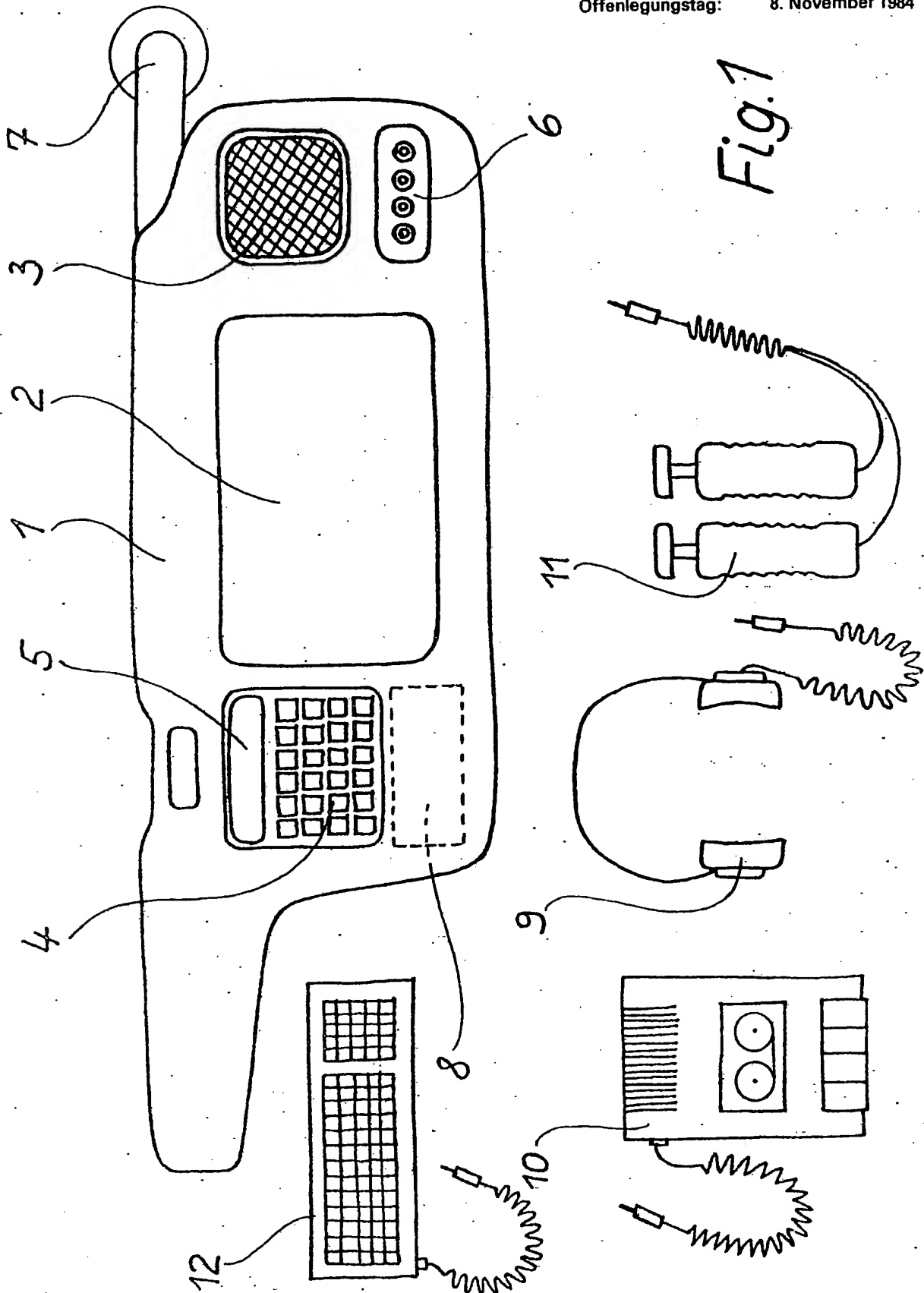


EXHIBIT 13

3 PAGES

In the United States Patent and Trademark Office

Serial Number: 09/232,566

Appn. Filed: 01/15/1999

Applicant: Rolf Jansen

Appn. Title: Tractor/Trailer Back-up Kit

Examiner/GAU: Tung Vo/2613

Mailed: 6/30/05

At: Houston, Texas

Request for Copy of Missing Reference

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In the Office Action mailed June 22, 2005, copy of the German patent DE 3316818 was enclosed, but only the first page of the translation was enclosed.

On page 3 of the Office Action, the examiner makes comments pertaining to pages 4 and 5 of the translation.

Since the applicant has a deadline to meet in responding to the Office Action, all the time waiting to receive the complete translation takes away from time available to prepare the response. THEREFORE, the applicant requests that a complete copy of the translation be mailed to him as soon as possible.

Respectfully submitted,

Rolf Jansen

Rolf Jansen, Applicant, pro se

P.O. Box 73161

Houston, TX 77273

Request for Copy of Missing Reference (Ser. No. 09/232,566) 2.

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Date: 6/30/05

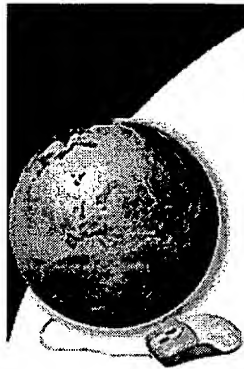
Rolf Jansen
Rolf Jansen, Applicant

Received today Request for Copy of Missing
Reference, from Applicant Rolf Jansen,
Serial Number 09/232,566, Appn. Filed
01/15/1999, Appn. Title, Tractor/Trailer
Back-up Kit, Examiner/GAU, Tung Vo/2613



EXHIBIT 14

1 PAGE



accommodations
budget lodgings

outdoor activities
adventure treks
bus and walking tours

available in
160 countries

Join



provided by
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travel-island.com

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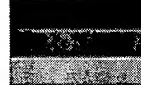
Search

Help | Site Map

Car Driving Information for Germany



driving information



Overview

General Info

Germany was the first country in the world to develop a national system of superhighways, and for many years its Autobahn system was a model for other nations. After unification, Autobahns in the eastern part of the country were significantly upgraded. Today Germany has nearly 6,000mi/9660km of Autobahns and an extremely well developed network of lesser highways. This makes traversing this country exceptionally easy and pleasant, and the German network is interconnected with networks in neighboring countries. Germany is about 500mi/805km long (from north to south) and 400mi/644km wide in its longest dimensions.

Requirements

You must be at least 21 years old (age may vary by car category) and have held your license for 1-3 years depending on the car category reserved. Drivers age 21-22 must purchase CDW. Drivers under the age of 25 may incur a young driver surcharge. Child safety seats are mandatory for children up to age 6. Seatbelts are mandatory.

Speed Limits

Speed limits in Germany are as follows: City 31mph/50kph Open Roads 62mph/100kph Highways 81mph/130kph is recommended but most autobahns have no speed limit.

Rules of the Road

Traffic travels on the right and streetcars do not have the right of way. They should be passed on the right on a two way street and on either side on a one-way street. Avoid the far left lane on the autobahn as speeds can easily exceed 100mph/161kph.

Fuel

Most fuel stations are open from 8am to 8pm. There are stations open 24 hours in some major cities and on the autobahn.

Tolls

There are no toll highways in Germany.

Parking

Parking is allowed only on the right side of the road except on one-way streets where both sides are valid. Parking spaces with meters are usually free of charge at night.

Car Rental Restrictions

General Information

Most car categories can be driven anywhere in Western Europe without restriction. Due to insurance regulations, there are restrictions on luxury car categories and on

EXHIBIT 15

3 PAGES

**Newnes
Television
and
Video Engineer's
Pocket Book**

Third edition

Eugene Trundle, TMIE (elect), MRTS, MISTC



Newnes

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JOHANNESBURG MELBOURNE NEW DELHI

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and via mirrors. Not all scenes are amenable to auto-focusing; sometimes the main picture feature is not central in the frame, and sometimes a degree of defocusing of some or all of the televised scene is required for production or artistic effects. For these reasons, and to conserve battery power where applicable, the auto-focus facility can be switched off.

The current trend is to use the video signal itself as reference for the auto-focus system as shown in Fig. 6.11. It generally gives more accurate results, and permits a choice of zone sizes for focus sampling.

VIEWFINDERS

The camera's electronic viewfinder (EVF) has three main functions. It frames the shot for the operator and checks optical focus during shooting; it relays information from the camera's system-control section on settings, status and operational mode; and it acts as picture monitor during in-the-field playback in the case of a camcorder. It is difficult to manufacture a very small colour screen with good enough colour fidelity to accurately judge the picture hue, or with sufficient definition to permit accurate optical focusing, especially with high-band and digital cameras.

The norm, then, is a black-and-white viewfinder tube of about 2.5 cm diagonal mounted in a 'chicken-leg' housing hinged at its back end on the top surface of the camera. It has an eyepiece and viewing lens with focus adjustment. The display tube is necessarily a low-energy device with small deflection angle. As in larger picture tubes, magnetic deflection and electrostatic beam-focus systems are used. The VF tube is driven by what amounts to a complete monitor circuit, including video amplifier and output stage; sync separator; time-bases; and high-voltage supplies for the picture-tube, the whole being miniaturised and designed to operate from its own (typically 5 V) supply rail, derived from the camera's own power supply via a stabiliser/regulator circuit. No external controls are needed, though brightness and beam-focus controls may be provided as semi-accessible presets. This complete independence of the EVF system is necessary to enable the viewfinder to perform its role as a video monitor during tape replay when the camera section is switched off. Although physically very small, the components and techniques of the EVF are just the same as are used in the TV receiver and monitors covered in the first half of this book.

Colour EVF

The fact that colour viewfinders struggle to do justice to the performance of a good video camera has not prevented manufacturers incorporating them in home-movie camcorders! A few models offer the best of both worlds, with a conventional black-and-white VF tube plus a small (4–10 cm diagonal) colour LCD display in a fold-out panel on one side of the camcorder body. In the *Viewcam* the rear panel of the camcorder consists of a colour LCD panel of 8–10 cm diagonal. While suffering from the above-mentioned shortcomings as a camera viewfinder, it does have the advantages of not needing to be held to the eye while shooting, and of affording more than one viewer (with difficulty!) to watch the playback on location. A third class of camcorder sports a conventional viewfinder housing, but it contains a mini-LCD panel in place of the little monochrome tube, again with an eyecup and lens. This stretches the cost versus performance of LCD technology tight, and the 'chicken-wire overlay' effect on the VF image can be very obtrusive.

VIEWFINDER INDICATIONS

All feedback to the camcorder operator comes via the viewfinder screen, composed and superimposed on the picture by a character-generator IC, which may be incorporated in the main processor chip. Working on indications sent to the processor from sensors on the tape deck, in the camera section and elsewhere, the character generator provides a wide range of status, indication and warning symbols, plus – very often – a simple titling facility so that captions and titles can be recorded on tape.

CAMCORDERS

Camcorders combine the camera principles described in this chapter with the videorecorder systems described in Chapters 13–19 of this book, and use miniature deck assemblies and (often) small head drums. They use either low- or high-band formats (see Chapter 14) and small cassettes of the Video 8 or VHS-C type. Hi-Fi stereo sound, either in f.m. or pulse-code form, is also incorporated in some models. Digital cameras will be dealt with in Chapter 19.

The requirements of small size, light weight and minimum power consumption, together with competition between makers and formats for the best performance and greatest sophistication, has put camcorders in the forefront of electronic technology. Surface-mounted

EXHIBIT 16

8 PAGES

Troubleshooting and Repairing Camcorders

Homer L. Davidson

TAB Books

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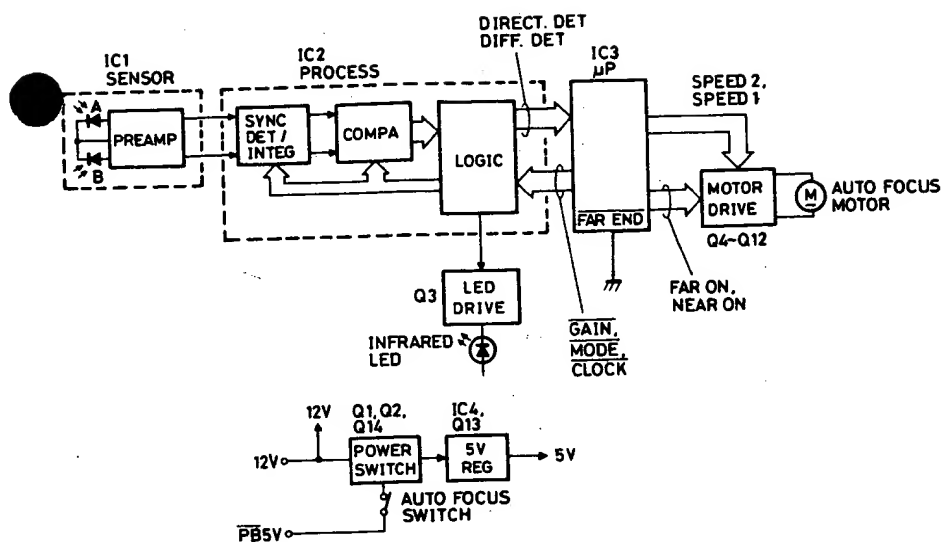
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3-33 RCA CPR100 auto focus block diagram. RCA

microprocessor IC3. The output signal from IC3 is applied to the motor drive circuits (Q4 through Q12), operating the auto focus motor (FIG. 3-34).

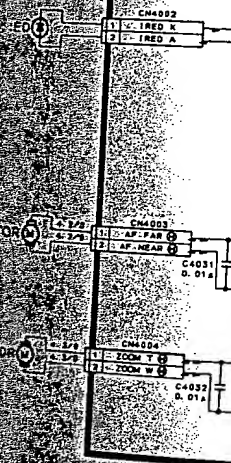
THE ELECTRONIC VIEWFINDER

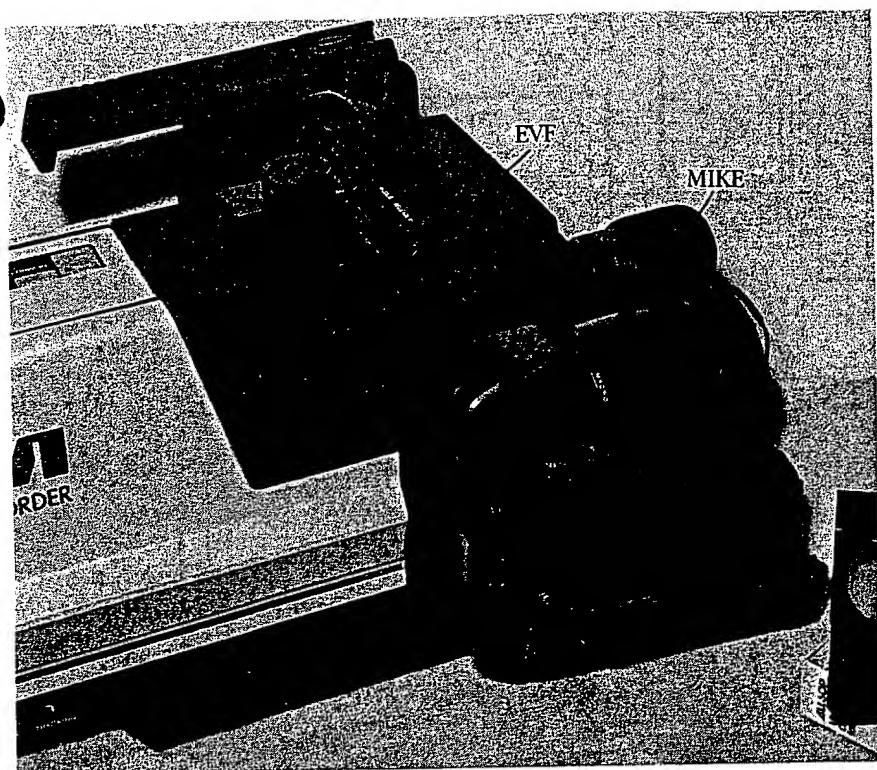
Although the most recent camcorders have the electronic viewfinder, some of the smaller cameras have the optical viewfinder. The electronic viewfinder (EVF) permits monitoring the image being shot or played back. The electronic viewfinder looks and acts somewhat like the small black-and-white TV chassis. The EVF unit is found at the front of the camcorder (FIG. 3-35).

The EVF circuits consist of a miniature picture tube with horizontal and vertical deflection circuits. The flyback transformer provides high voltage to the CRT. Vertical and horizontal sync circuits are generated and fed to the EVF deflection and VCR system control circuits. A small amplifier and sync separation circuit round up the EVF circuits (FIG. 3-36).

Pentax PV-C850 (8 mm) Electronic Viewfinder Circuits The EVF circuits consist of the video, vertical and horizontal deflection, and high-voltage circuits. The video is applied at pin 10 of IC1801 (FIG. 3-37). The video signals from the main circuit board in the VTR come out through pin 11, and are amplified by IC1801 and applied to the grid of the CRT after passing through amplifier Q1802.

The video signal passing through the low-pass filter (LPF), which removes spurious high-frequency components, is applied to the sync separator circuits, which separate the vertical and horizontal sync signals. The vertical sync separator separates the vertical sync signal from the composite sync signal. The vertical oscillator generates a sawtooth waveform to the vertical drive, which produces vertical drive signal (pins 16 and 17) to the vertical deflection coils.





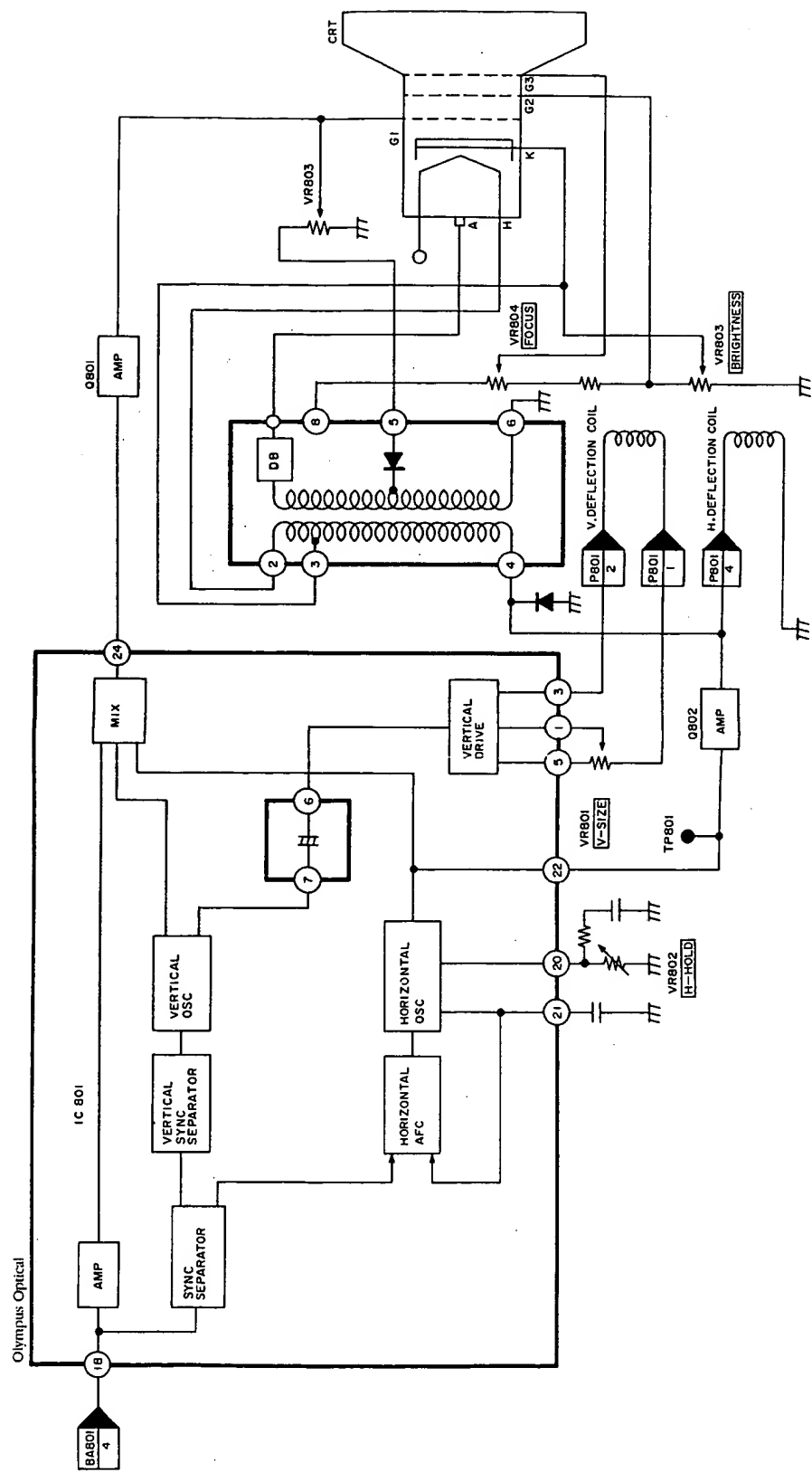
3-35 Location of the electronic viewfinder (EVF) in the RCA CPR300 camcorder.

In the high-voltage circuit, the horizontal drive circuit generates the high voltage for the CRT (FIG. 3-38). Pin A of T1801 supplies 2.5 kV to the anode of the CRT. Pin B supplies approximately 500 V to the focus circuits. R1823 and R1824 provide a dividing circuit that supplies 250 V to grid 2. Pin 4 supplies approximately 70 V to the brightness circuits. Pins 1 and 6 supply a flyback pulse to light the filament of the CRT.

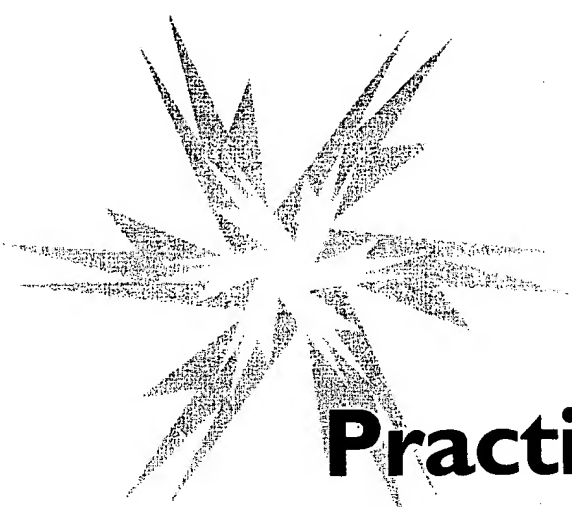
Realistic 150 (VHS-C) Electronic viewfinder (EVF) In some camcorders, the EVF assembly is locked in place with a sliding plastic lock assembly (FIG. 3-39). The EVF assembly may be adjusted to either side for easy viewing. Push the lock to one side and the EVF assembly can be removed after removing the EVF plug-in cable to the camera section.

IC1801 amplifies the video signal and provides sync separation, vertical oscillator, vertical drive, and horizontal oscillator circuits in one IC. The video output at pin 5 of IC1801 is applied to the video grid 1 through a driver (Q1802) (FIG. 3-40).

After the video signal enters the low-pass filter (C1818, R1817, LPF), which removes high-frequency components, it enters IC1801 at pin 11. The sync separator separates the composite sync signal from the sync signal and is applied to the vertical sync separator and H sync phase detector circuit



3-36 EVF block diagram of the Olympus VX-801 camcorder.



Practical Electronics for Inventors

Paul Scherz

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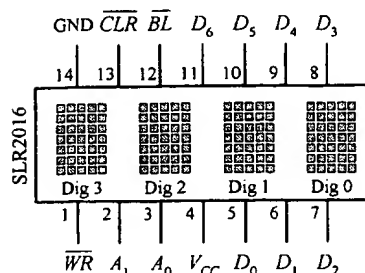
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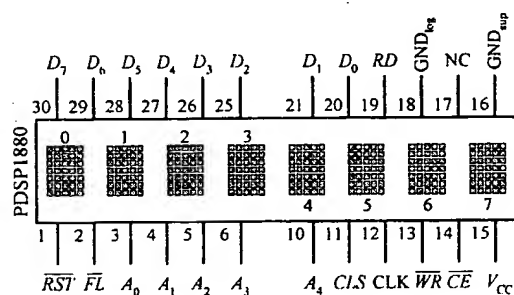
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SLR2016 (Siemens) 4-Digit 5 x 7 Dot Matrix
Alphanumeric Intelligent Display

SLR2016 Character Set

ANCI CODE	123	4	5	6	7	8	9	10	11	12	13	14	15	16	17	18	19	20	21	22	23	24	25	26	27	28	29	30	31	32	33	34	35	36	37	38	39	40	41	42	43	44	45	46	47	48	49	50	51	52	53	54	55	56	57	58	59	60	61	62	63	64	65	66	67	68	69	70	71	72	73	74	75	76	77	78	79	80	81	82	83	84	85	86	87	88	89	90	91	92	93	94	95	96	97	98	99	100	101	102	103	104	105	106	107	108	109	110	111	112	113	114	115	116	117	118	119	120	121	122	123	124	125	126	127	128	129	130	131	132	133	134	135	136	137	138	139	140	141	142	143	144	145	146	147	148	149	150	151	152	153	154	155	156	157	158	159	160	161	162	163	164	165	166	167	168	169	170	171	172	173	174	175	176	177	178	179	180	181	182	183	184	185	186	187	188	189	190	191	192	193	194	195	196	197	198	199	200	201	202	203	204	205	206	207	208	209	210	211	212	213	214	215	216	217	218	219	220	221	222	223	224	225	226	227	228	229	230	231	232	233	234	235	236	237	238	239	240	241	242	243	244	245	246	247	248	249	250	251	252	253	254	255	256	257	258	259	260	261	262	263	264	265	266	267	268	269	270	271	272	273	274	275	276	277	278	279	280	281	282	283	284	285	286	287	288	289	290	291	292	293	294	295	296	297	298	299	300	301	302	303	304	305	306	307	308	309	310	311	312	313	314	315	316	317	318	319	320	321	322	323	324	325	326	327	328	329	330	331	332	333	334	335	336	337	338	339	340	341	342	343	344	345	346	347	348	349	350
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PDSP1880 (Siemens) 8-Character 5 x 7 Dot Matrix Alphanumeric Programmable Display



PDSP1880 Character Set

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FIGURE I.9

1.3 Liquid-Crystal Displays

In low-power CMOS digital systems (e.g., battery- or solar-powered electronic devices), the dissipation of an LED display can consume most of a system's power requirements, something you want to avoid, especially since you are looking to save power when using CMOSs anyway. Liquid-crystal displays (LCDs), on the other hand, are ideal for low-power applications. Unlike a LED display, an LCD is a passive device. This means that instead of using electric current to generate light, it uses light that is already externally present (e.g., sunlight, room lighting). For the LCD's optical effects to occur, the external light source need only supply a minute amount of power (within the mW/cm^2 range).

One disadvantage with LCDs is their slow switching speeds (time it takes for a new digit/character to appear). Typical switching speeds for LCDs range from

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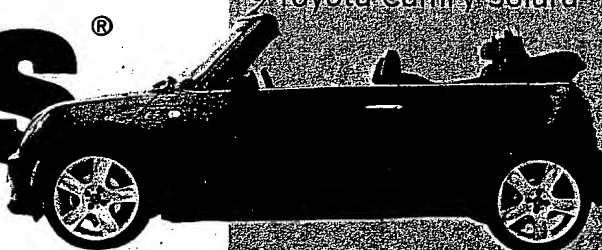
EXHIBIT 17
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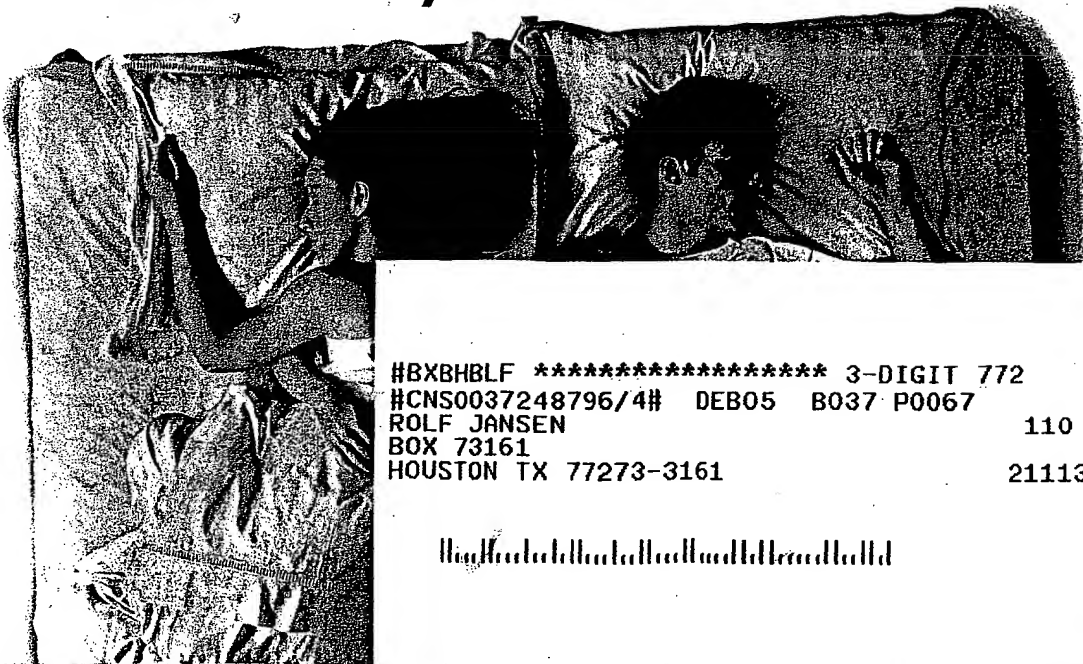
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- Is FIRMER really BETTER?



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|||||

COMPUTER MONITORS

More screen for less

In computer monitors, as in TVs, models with LCD technology are becoming bigger, cheaper, and more dominant in the marketplace.

During 2004, the liquid-crystal display market shifted distinctly from 15-inch monitors to 17- and 19-inch models. Prices for 17-inch models, the size most people buy, now start at \$250, compared with \$450 last year. And 60 percent of the computer monitors now sold in the U.S. are LCDs.

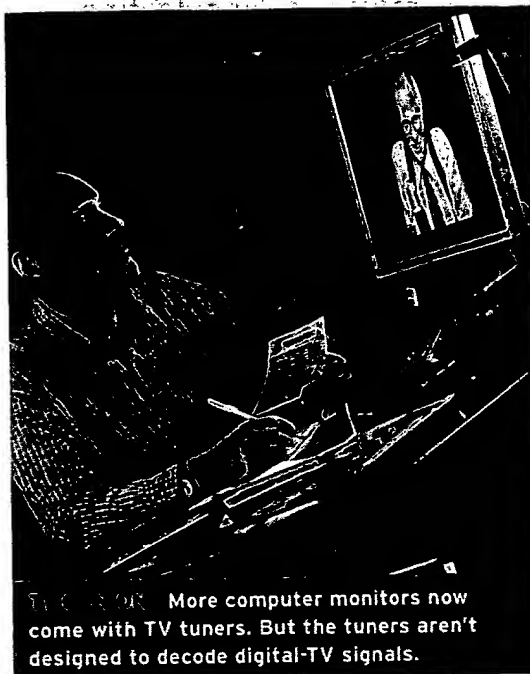
LCDs are beginning to dominate the monitor market for practical reasons: They take up far less desk space than a CRT, or cathode-ray tube, monitor and weigh about 15 pounds, vs. 30 to 50 pounds for a CRT. But a CRT still has some advantages (see CloseUp, below).

Here's what we found in our latest tests of LCD monitors:

They're getting wider. More LCDs have screens with the wide shape found on digital TVs. The width is handy for viewing and editing photos and running multiple programs.

They're more versatile. More than half the models we tested had stands that allow you to lift, lower, or tilt the screen. That's useful because LCD screens are less bright and sharp when viewed at an extreme angle. More LCDs can rotate from a landscape to portrait orientation—a handy feature when you want to view documents or Web pages.

Convergence with TVs isn't here yet. Computer equipment and TV sets are becoming a little more alike. Samsung, Sony, and others now offer monitors with TV tuners and LCD TVs with computer connections. But big differences between the two types of devices still remain. While both share LCD technology, monitors designed for computer use generally display computer content



More computer monitors now come with TV tuners. But the tuners aren't designed to decode digital-TV signals.

more clearly than TV sets do. Computer monitors with built-in TV tuners cost \$100 to \$200 more than those without and can't decode digital broadcasts.

HOW TO CHOOSE

Consider your budget. For a monitor to use with a \$500 computer, an economical CRT may make the most sense.

Consider how you'll use it. For most tasks, a 17-inch monitor is fine. But if you have poor vision, routinely edit photos,

run several programs at once, or play games often, consider models that are 19 inches or larger.

Consider controls. Look for conveniently placed buttons that adjust contrast, brightness, and other settings that affect the image. Some sleek designs hide their controls, making adjustments more difficult.

Consider viewing angle. Images on LCD screens fade as you move left, right, up, or down. Many models (see the Ratings) have a wider viewing angle than we've seen in the past.

Shop for the best warranty. Look for three-year parts-and-labor coverage, especially with expensive models.

Donate or recycle your old CRT. If your CRT works, keep it as a spare or donate it at www.cristina.org. Otherwise, check with local agencies to find out if your municipality has a recycling program that accepts electronic waste. Many offer collection or drop-off programs. Also consult the following Web sites for recycling sources in your area: www.eiae.org/index.cfm and www.earth911.org.

closeup

REASONS TO CONSIDER A CRT

Big and bulky, a CRT monitor can gobble up a huge section of your desktop, be difficult to maneuver or move, and consume twice as much energy—up to 80 watts—as a comparably-sized LCD. Nevertheless, for some people, it may still be worth considering, for these reasons:

A CRT offers the most screen for the money. A 19-inch model can be on your desk for less than \$200, compared with \$350 and up for an LCD.

It may perform very well. Two 17-inch models (16-inch viewable-image size) we tested, the IBM ThinkVision C170, \$185, and the IBM E74, \$140, performed better overall than half the LCDs in the Ratings.

It's superior for photographers, designers, and gamers. CRTs generally deliver slightly truer colors, making them the preferred medium for graphic designers and digital photographers. They also render fast-moving objects better than LCDs, making them attractive to serious gamers. Unlike LCDs, they can be readily viewed from extreme angles.



BULKY Most CRTs' depth equals their screen size.

In the United States Patent and Trademark Office

Mailed 199 9, Jan 15

Box Patent Application
Assistant Commissioner for Patents
Washington, District of Columbia 20231

EXHIBIT 19

6 PAGES

Fee Transmittal

First-Named Applicant Rolf Jansen
Title of Invention: " Tractor/Trailer Back-up Kit "
Total Payment Enclosed (From Calculation Below): \$ 395.00 ☒ Check ☐ Money Order

Sir:

Enclosed is the following small entity filing fee for the above patent application:

Fee Code	Fee Description	Fee (\$)
214	Provisional Pat. Appn. Filing Fee	
201	Basic Utility Appn. Filing Fee	<u>395.00</u>
206	Basic Design Appn. Filing Fee	
	Subtotal (1)	<u>395.00</u>
203	Total Claims: _____ - 20 = _____ ; X _____ (fee for each claim over 20) =	<u>N/A</u>
202	Tot. Indep. Claims _____ - 3 = _____ ; X _____ (fee for each indep. claim over 3) =	<u>N/A</u>
	Subtotal (2)	<u> </u>
Total Payment Enclosed [Sum of Subtotals (1) and (2)]		<u>395.00</u>

Very respectfully,

Rolf Jansen
Signature of First-Named Applicant

Rolf Jansen
Print Name of First-Named Applicant

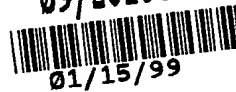
P. O. Box 73161
Address

Houston, TX 77273

The following received today:

Patent Application for Rolf Jansen for
"Tractor/Trailer Back-up Kit", consisting of
39 sheets specification, claims, and
abstract, declaration signed 1999 Jan.15,
5 sheets formal drawing, small entity declar-
ations (2 of them), and check nr. 978 for
\$395.00:

JC530 U.S. PTO
09/232566



01/15/99

Patent Application of
Rolf Jansen
for
TRACTOR/TRAILER BACK-UP KIT

Background - Field of Invention

This invention relates to closed-circuit television, specifically to an improved means, when backing, for a driver of a tractor/trailer rig, or other motor vehicle, to see what is to the rear when the unaided view is obstructed.

Background - Cross-Reference to Related Application

This application claims the benefit of Provisional Patent Application Ser.# 60/071,830, filed January 20, 1998.

Background - Description of Prior Art

I was an adjuster for an independent claims service that specialized in on-the-scene accident investigations for motor freight lines that were self-insured; and the most common accident occurred when a tractor/trailer rig was being backed.

When the trailer is the rectangular-box type, the driver can

Heavy cotton denim, of the kind used to make stone-washed blue jeans, insulates well from heat and cold. I made a case of this material to cradle the CITIZEN 2.9 inch LCD monitor. There is a window in the case for the monitor screen. The case is made wide enough to enclose the plugs and cables that fit into power and video jacks to the LCD monitor.

On the back of the case is a sewn patch with a slot to fit a banker's clasp, which is a long, thin clip of sufficient length to extend the entire vertical length of the sunvisor, and hold the denim case securely.

I designed the denim case to have a seamless underbody, a soft, rounded form that cradles the LCD monitor and aids in absorbing vibrations.

When the sunvisor-mounted case is in the UP position, the monitor is further insulated by the overhead lining, the interior side of the vehicle roof.

Also, the use of a portable sunscreen to cover the interior of the windshield when the vehicle is parked in the summer sun can diminish buildup of heat.

Getting the mirror image

One more thing needs to be done to really increase the effectiveness of the sunvisor-mounted camcorder-type LCD monitor. The image in the screen needs to be a mirror image, like looking in a rear view mirror.

If such an image is possible, then the driver facing forward sees in the monitor screen (when the sunvisor is lowered) what

and power jacks on the left side of the monitor. This keeps the plugs from coming loose, hides unsightly wires; and the extended space gives a looseness that aids in absorbing vibrations. The extended section is shown in Fig. 4.

A separate patch of cloth 14, as shown in Fig. 2, is sewn to the back of the denim case 30. This patch provides a vertical slot, for inserting a long, thin metal clip, called a banker's clasp 16, that can be purchased from Acco USA, Inc., Wheeling, Illinois.

This thin, metal clasp, long enough to extend the whole vertical depth of a motor-vehicle sunvisor, securely holds the case, with monitor, to the retracted side of the sunvisor; and holds the case and monitor securely when the sunvisor 22 (as shown in Fig. 3) is lowered, and the monitor is in front of the face of the truck driver.

As shown in Fig. 3, the video and power supply cables that extend from the left top of the denim case, through the gap where the top flap folds over, are wrapped in spiral wrap 28, obtainable from RadioShack, to make one organized strand, rather than two loose strands of wire. The video and power supply lead cables, with plugs, come with the monitor when purchased.

As shown in Fig. 2, the top flap 20 that folds over is attached by a 1/4" wide strip of Velcro 18 that extends the length of the flap. Opening of the top flap allows the monitor to be put in or taken out of the case.

The video cable and power supply cable, coming from the monitor, and made one strand by spiral wrap, follow the contours

embodiment thereof. Many other variations are possible. For example:

A case is a form of covering. A covering could be fixed to the outside of the monitor itself.

The case or covering could be made of a variety of materials that provide insulation.

Means for mounting the case to the sunvisor can vary, e.g., the shape, size, and material of the clip or clasp can vary; the clip or clasp could be attached by an adhesive backing.

The rear plate, to which the enclosure for the micro-video, pin-holed lens camera is mounted, need not be a license plate but could be a plate with a company logo on it, or with a phrase on it, such as Drive Safely.

The means for mounting the enclosure on the back side of the plate can vary, e.g., by using machine screws, and washers, rather than epoxy glue, as long as weather-proof integrity of the enclosure was maintained. (I chose to epoxy glue the enclosure to the plate so no screw heads and washers would show on the front side of the plate, to add to concealment.)

The pane that attaches to the front face of the enclosure could be made of another material besides LEXAN XL. The dimensions of the pane could vary.

Also the dimensions, material, and color of the enclosure could vary.

Accordingly, the scope of the invention should be determined not by the embodiment(s) illustrated, but by the appended claims and their legal equivalents.

different from those in the instant appeal. In *Trust* the attorney switching firms contacted his former client to inform him of the possible conflict. The attorney also provided files to his former client to assist the former client in determining if he wished to object to the representation. The former client promised to contact the attorney if he objected to the representation but he waited two and one-half years before bringing an objection.

In contrast to the facts in *Trust*, the facts in the instant appeal do not indicate an intent by Seagate to waive its right to object to representation of Atasi by the Skjerven firm. Kallman did not contact Seagate to inform it of the possible conflict. Instead Karl Limbach⁹ learned of the conflict from a telephone call to Kallman. Seagate did not promise to contact Kallman if Seagate objected to the representation and the motion to disqualify was brought about 6 months after Seagate learned of the conflict. During this 6 months the proceedings and discovery had been stayed and the motion was brought on the same day Atasi moved to lift the stay.

In addition to the facts, we must consider the policies involved. The doctrine of waiver exists as a means to balance the competing policies relevant to imputed disqualification. The policy of preserving the former client's confidences is opposed by the policy of giving the opposing party the freedom of choice of legal counsel. See *Model Rules of Professional Conduct* Official Comments to Rule 1.10. (1983).⁹ The doctrine of waiver protects the opposing party's freedom of choice of legal counsel. However waiver should only apply where, on the facts present, the balance of the competing policies weighs in favor of the opposing party's freedom of choice of legal counsel. This occurs particularly when a motion to disqualify is used in an abusive manner as a part of litigation tactics. This occurred in *Trust*. Since the type of abuse present in *Trust* is not present in the instant appeal there is no waiver.

Atasi will undoubtedly suffer in time and expense as a result of the disqualification of the Skjerven firm. This is particularly unfortunate since it is the attorney's actions, not Atasi's, which resulted in the disqualification. It was Kallman and the Skjerven firm,

not Atasi, who knew of the possible conflict.¹⁰ On the former client's side it was Limbach, not Seagate, who first learned of the conflict of interest.

Though Atasi will undoubtedly suffer as a result of the imputed disqualification of the Skjerven firm, that alone is insufficient to prevent the disqualification. Again, there are competing policies affecting the disqualification rule and a balancing is necessary to determine which policy should have priority. Whenever a result is reached by choosing one policy over another the party in favor of the subordinated policy usually suffers. In the instant appeal the policy of preserving the former client's confidences is entitled to priority over the policy of freedom of choice of counsel.

CONCLUSION

Appellant had the burden of showing an absence of "any sound" basis in the record to support the district court's order. Finding neither legal error nor abuse of discretion in the order of the district court, we affirm.

AFFIRMED

EXHIBIT 20 4 PAGES

Court of Appeals, Federal Circuit

In re Wright

No. 87-1464

Decided May 24, 1988

PATENTS

1. Patentability/Validity — Obviousness — In general (§115.0901)

Patent and Trademark Office erred in denying on grounds of obviousness patent for carpenter's level which had as its primary purpose improved pitch-measuring capability over prior art but which incorporated prior art of internal pin to improve visibility of level bubble, since obviousness determinations under 35 USC 103 must include consideration of invention as whole, including its structure, its properties, and problem it

⁹ A partner in the firm of Limbach, Limbach, & Sutton, Seagate's counsel after the Flehr firm withdrew.

¹⁰ The Model Rules have not been adopted by California or the Northern District of California but Rule 1.10 relating to imputed disqualification and the official comments thereto are instructive in the instant appeal.

¹⁰ As part of a settlement agreement in a prior action (*Atasi v. Priam*) the Flehr firm was prohibited from representing Seagate in the instant case. Thus Atasi deprived Seagate from freedom of choice of counsel.

solves, and thus unobviousness of level's structure for its intended purpose is relevant to obviousness determination.

Appeal from Board of Patent Appeals and Interferences' rejection of claims 1 through 8 of patent application, serial no. 399,850, of Randall J. Wright. Reversed.

Robert W. Slater and Jones, Day, Reavis & Pogue (Robert L. Lindgren, on brief), Chicago, Ill., for appellant.

Lee E. Barrett, associate solicitor (Joseph F. Nakamura, solicitor and Fred E. McKelvey, deputy solicitor, on brief), for appellee PTO.

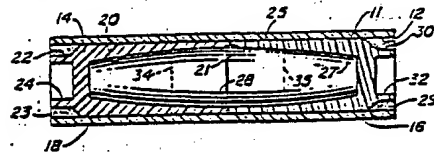
Before Friedman, Newman, and Mayer, circuit judges.
Newman, J.

The judgment of the Board of Patent Appeals and Interferences of the United States Patent and Trademark Office, rejecting claims 1 through 8 of patent application Serial No. 399,850 of Randall J. Wright for "Level Vial with Extended Pitch Range", is reversed.

The Invention

Instruments that are commonly called carpenter's levels have long been known. They used small liquid-filled transparent vials with an entrained gas bubble; the vials function by gravity, the bubble automatically seeking the highest point within the vial. The vial is attached to a support, such that when the surface on which the support is placed is level, the bubble is centered. Thus, the position of the bubble shows the orientation of the vial and of the support.

Levels in common use today are made from barrel-shaped vials, mounted so that the bubble may be viewed from either side of the vial. An example of a barrel-shaped vial set in a molded plastic housing is shown in Vaida U.S. Patent No. 3,871,109, of record:



These levels of the prior art are limited in their pitch measuring¹ capability because of the limited amount of curvature that can be formed in the molded barrel vial shape.

¹ The pitch is the degree to which a given surface is not level. "Pitch" vials measure a range of pitch angles.

The Wright invention is a level-measuring instrument that has an increased range of pitch measurement capability, yet retains the advantages of the barrel vials of the prior art. Claim 1 is representative:

1. A level vial comprising a body having a bore formed with a barrel shaped portion having opposed ends and wherein the barrel curvature is defined by a first radius of curvature,

the barrel shaped portion of the bore having a cross-sectional dimension generally decreasing from the center thereof in axially opposed directions towards the ends thereof,

an axially elongated core member disposed within the bore and between the opposed ends thereof in coaxial relationship with the barrel shaped portion of the body and having a maximum cross-sectional dimension and having a second radius of curvature exceeding that of the first radius of curvature of the barrel shaped bore portion,

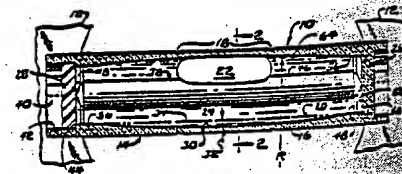
a quantity of fluid disposed within the bore and being insufficient to fill the bore and to provide a bubble therein having a dimension sufficient to simultaneously contact the surfaces of the barrel shaped bore portion and the core member,

means for hermetically sealing the bore to contain the fluid and to maintain the bubble therein,

the vial body having a transparent portion and indicator means associated therewith to permit visual bubble observation and for indicating preselected positions of the bubble in the vial

and wherein the surfaces of the barrel shaped bore portion and the core member coact with the bubble to produce gradual bubble movement axially within the barrel shaped bore portion without abrupt bubble acceleration and while providing a wide range of visually observable angular measures.

The Wright structure is illustrated as follows:



a level-measuring increased range of ability, yet retains el vials of the prior art.

ing a body having a rel shaped portion d wherein the bar by a first radius of

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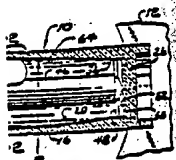
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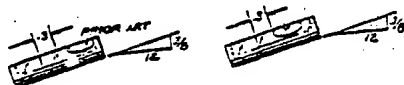
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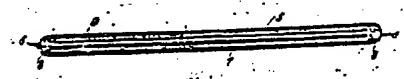
According to the Wright disclosure, by combining a core pin (46) and a barrel vial (14), the indicator bubble (22) does not move as far along the barrel with a given change in pitch, compared with the barrel vials of the prior art. Wright illustrates this phenomenon in his specification (showing a pitch change of 3/8 inch per 12 inches):



Thus the Wright level can measure greater changes of pitch before the bubble reaches the end of the vial.

The Rejection

The Board agreed with Wright that his claimed combination was new. However, because it was known to place a core pin in a cylindrical vial in order to increase the visibility of the bubble, as shown in Bishop U.S. Patent No. 771,803:



the Board held that it would have been obvious to construct a level having a core pin in the barrel-shaped vial of Vaida, irrespective of the purpose. The Commissioner on appeal argued that the Bishop and Vaida references presented, in combination, a prima facie case of unpatentability, stating:

[A] claimed invention may be unpatentable if it would have been obvious for reasons suggested by the prior art, even though those reasons may be different from the reasons relied upon by the inventor and may result in a different advantage.

The PTO position is that since it would have been obvious to make the Wright combination in order to improve visibility of the bubble, it is immaterial that Wright's combination improves pitch measurement.

Discussion

The Commissioner argues that if it is obvious to combine the teachings of prior art references for any purpose, they may be combined in order to defeat patentability of the applicant's admittedly new structure.

The PTO states that "a claimed invention may be unpatentable if it would have been obvious for reasons suggested by the prior art, even though those reasons may be different from the reasons relied upon by the inventor and may result in a different advantage." The PTO position is that it is irrelevant that Wright's structure was for a purpose, and has properties, that are neither obtainable from the prior art structures, nor suggested in the prior art. In this lies the PTO's error.

We repeat the mandate of 35 U.S.C. §103: it is the invention as a whole that must be considered in obviousness determinations. The invention as a whole embraces the structure, its properties, and the problem it solves. See, e.g., *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1025, 226 USPQ 881, 886 (Fed. Cir. 1985) ("In evaluating obviousness, the hypothetical person of ordinary skill in the pertinent art is presumed to have the 'ability to select and utilize knowledge from other arts reasonably pertinent to [the] particular problem' to which the invention is directed"), quoting *In re Antle*, 444 F.2d 1168, 1171-72, 170 USPQ 285, 287-88 (CCPA 1971); *In re Antonie*, 559 F.2d 618, 619, 195 USPQ 6, 8 (CCPA 1977) ("In delineating the invention as a whole, we look not only to the subject matter which is literally recited in the claim in question . . . but also to those properties of the subject matter which are inherent in the subject matter and are disclosed in the specification") (emphasis in original).

The determination of whether a novel structure is or is not "obvious" requires cognizance of the properties of that structure and the problem which it solves, viewed in light of the teachings of the prior art. See, e.g., *In re Rinehart*, 531 F.2d 1048, 1054, 189 USPQ 143, 149 (CCPA 1976) (the particular problem facing the inventor must be considered in determining obviousness); see also *Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Co.*, 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984) (it is error to focus "solely on the product created, rather than on the obviousness or nonobviousness of its creation") (quoting *General Motors Corp. v. U.S. Int'l Trade Comm'n*, 687 F.2d 476, 483, 215 USPQ 484, 489 (CCPA 1982), cert. denied, 459 U.S. 1105 (1983)).

Thus the question is whether what the inventor did would have been obvious to one of ordinary skill in the art attempting to solve the problem upon which the inventor was working. *Rinehart*, 531 F.2d at 1054, 189 USPQ at 149; see also *In re Benno*, 768 F.2d 1340, 1346, 226 USPQ 683, 687 (Fed. Cir.

1985) ("appellant's problem" and the prior art "present different problems requiring different solutions").

[1] The problem upon which Wright was working was improving the pitch-measuring capability of the level, not the visibility of the bubble. The PTO, having conceded that Wright's structure was unobvious for his intended purpose, erred in holding that this was not relevant. The problem solved by the invention is always relevant. The entirety of a claimed invention, including the combination viewed as a whole, the elements thereof, and the properties and purpose of the invention, must be considered.

Factors including unexpected results, new features, solution of a different problem, novel properties, are all considerations in the determination of obviousness in terms of 35 U.S.C. §103. When such factors are described in the specification they are weighed in determining, in the first instance, whether the prior art presents a prima facie case of obviousness. See, e.g., *In re Margolis*, 785 F.2d 1029, 1031, 228 USPQ 940, 942 (Fed. Cir. 1986) (comparative data in the specification must be considered in PTO determination of unexpected results, as part of "the entire body of evidence . . . which must be weighed in the first instance by the PTO.") When such factors are brought out in prosecution before the PTO, they are considered in determining whether a prima facie case, if made based on the prior art, has been rebutted. See, e.g., *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 789 (Fed. Cir. 1984) (rebuttal evidence is considered along with all other evidence of record). In either case, the requisite view of the whole invention mandates consideration of not only its structure but also its properties and the problem solved.

Applicant Wright agrees that he has combined old elements. The Commissioner agrees that Wright has achieved a new combination, and that the result obtained thereby is not suggested in the references. The patentability of such combinations is of ancient authority. See, e.g., *Prouty v. Draper*, 41 U.S. (16 Pet.) 336, 341 (1842); *Eames v. Godfrey*, 68 U.S. (1 Wall.) 78, 79-80 (1863); *Gill v. Wells*, 89 U.S. (22 Wall.) 1, 25 (1874); see also H.T. Markey, *Why Not the Statute?*, 65 J. Pat. Off. Soc'y 331, 333-34 (1983) ("virtually all inventions are 'combinations', and . . . every invention is formed of 'old elements' . . . Only God works from nothing. Man must work with old elements").

The PTO position that the claimed structure is prima facie obvious is not supported by the cited references. No reference shows

or suggests that properties and results of Wright's claimed structure, or suggests the claimed combination as a solution to the problem of increasing pitch measurement capacity. It is not pertinent whether Wright's new structure also has the prior art attribute of increased visibility of the bubble, for that is not his invention.

The Commissioner on appeal defends the fact that the Board and the examiner never reached this analysis. The Board relied on *In re Wiseman*, 596 F.2d 1019, 201 USPQ 658 (CCPA 1979), to support the Board's statement:

If the claimed subject matter would have been obvious from the references, it is immaterial that the references do not state the problem or advantages ascribed thereto by appellant.

Wiseman does not support the generalization that the Board attributes to it. In *Wiseman* the prior art reference showed a similar problem and suggested a similar solution to that of the applicant. Specifically, the prior art showed a disc brake having grooves for the purpose of venting dust generated during use; the applicant showed a disc brake having grooves for the purpose of venting steam generated during use. The applicant asserted no results or properties that were not fairly suggested by the prior art. The court's discussion in *Wiseman* must be viewed in context, and as with all section 103 decisions, judgment must be brought to bear based on the facts of each case.

Conclusion

The rejection of claims 1 through 8 was in error. The Board's decision is
REVERSED

District Court, M.D. North Carolina

Yates-American Machine Co. Inc. v.
Newman Machine Co. Inc.

No. C-86-958-G

Decided February 22, 1988

PATENTS

1. Practice and procedure in U.S. Patent and Trademark Office — Re-issue — In general (§110.1301)

JUDICIAL PRACTICE AND PROCEDURE

Procedure — Motions (§410.31)

Stay of suit seeking declaration of non-infringement, invalidity, and/or unenforceability

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